119-652

# TRANSCRIPT OF RECORD.

## SUPREME COURT OF THE UNITED STATES.

**OCTOBER TERM, 1886.**

No. 94.

HOBART B. IVES, APPELLANT,

*vs.*

JOSEPH B. SARGENT.

APPEAL FROM THE CIRCUIT COURT OF THE UNITED STATES FOR THE DISTRICT OF CONNECTICUT.

**FILED OCTOBER 6, 1883.**

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JUDD & DETWEILER, PRINTERS, WASHINGTON.

1, 2, & 3. U. S. Circuit Court, Dist. of Connecticut. In Equity.

HOBART B. IVES, Compl'nt & Appellant,
*v.*
JOSEPH B. SARGENT, Def't & Appellee.

To the honorable the Supreme Court of the U. States:

The appeal of Hobart B. Ives, the above-named complainant and appellant, respectfully showeth:

That on the 15th day of May, 1882, the above-named complainant filed his bill in the circuit court of the United States for the district of Connecticut against the above-named defendant and appellee.

That said bill alleged that Frank Davis, of North Adams, Massachusetts, was the original owner and patentee of certain letters patent of the United States, issued to him on the 20th day of January, 1878, for a new and useful improvement in door-bolts; that on the — day of ——, 1879, the said Davis duly assigned said letters patent to the complainant, and that afterwards, on the application of the complainants, the said letters patent were duly reissued to him as the assignee of said Frank Davis, said reissue letters patent being dated the 18th day of October, 1881, and that the complainant had ever since
4 owned the same. And said bill further charged that the defendant had infringed said reissue letters patent by making and selling door-bolts which were covered by the claims of said reissue letters patent, and prayed for an injunction and judgment for damages, &c., as appears of record.

Said bill having been duly served on the defendant, he appeared and filed his answer thereto, in which he denied that he had infringed said reissued letters patent, and as a further defense alleged that said reissue letters patent were void.

Issue was joined by filing of replication in due season. And complainant, to establish said issue on his part, put in evidence the letters patent originally granted to Frank Davis, April 9, 1878; also the assignment of the same and of all reissues and extensions thereof by said Frank Davis to the complainant dated May 28, 1879; also the reissue letters patent, dated October 18, 1881, issued to Frank Davis, as assignor to the complainant, and further put in evidence the depositions of Frank Davis, Hobart B. Ives, Joseph D. Mansfield, and George Terry, as appears of record.

The defendant, to maintain the issue on his part, introduced in evidence the deposition of Purmont Bradford, as appears of record. There was no rebutting testimony offered.

The cause came to a final hearing on the 1st day of May,
5 1883, and was fully presented to the court upon the pleadings and testimony and the arguments of counsel for the respective parties.

On the 2d day of October, 1883, the court rendered a final decree adjudging the complainant's reissue patent void and dismissing the bill with costs to the defendants.

And now this complainant, being aggrieved by the said judgment and decree of the court and claiming that he was entitled to a decree

in his favor that the said reissue patent was valid and had been infringed by defendant and for an injunction and damages, appeals from said judgment and decree to your honorable court.

And complainant prays that the said decree of the said circuit court, with the opinion filed therewith, and the bill, answer, pleadings, depositions, evidence, exhibits, and other proceedings therein, may be sent to the Supreme Court of the United States without delay, and that the Supreme Court will proceed to hear the said cause anew, and that the said decree of said circuit court may be reversed and set aside and a decree rendered sustaining the validity of said reissue letters patent, and that defendant has infringed the same, and directing the said circuit court to render judgment in conformity therewith for an accounting by defendant of the profits and damages which complainant has sustained by such infringement, or will grant such other relief as may be appropriate and equitable.

6 Dated October 1st, A. D. 1883.

H. T. BLAKE,
*Solicitor & of Counsel for Complainant.*

7 U. S. Circuit Court, District of Connecticut. In Equity.

HOBART B. IVES *v.* JOSEPH B. SARGENT.

Whereas the above-named complainant has taken his appeal to the Supreme Court of the United States from the judgement and decree of the above-named circuit court, dismissing the above-named suit with costs to the defendant;

Now we, the undersigned, do, in consideration of the premises, jointly and severally acknowledge ourselves and each of us, our and each of our heirs, executors, administrators, and assigns, held and firmly bound unto the above defendant in said cause in the sum of two hundred and fifty dollars, conditioned that said complainant shall prosecute said appeal to effect and shall pay to said defendant all costs that may be recovered or be due to him in said circuit court or said Supreme Court in case the said complainant shall fail so to do.

Dated New Haven, October 2d, 1883.

GEO. M. GRISWOLD. [SEAL.]
H. A. BENNETT. [SEAL.]

Witness:
GEORGE I. MAURER.

Approved Oct. 4, 1883.

N. SHIPMAN, *Judge.*

8 By the Hon. Nathl. Shipman, one of the judges of the circuit court of the United States for the district of Connecticut, to Joseph B. Sargent:

Whereas Hobart B. Ives has appealed to the Supreme Court of the United States from a decree lately rendered in the circuit court of the United States for the district of Connecticut, made in favor of

you, the said Joseph B. Sargent, and have filed the security required by law, you are therefore hereby cited to appear before the said Supreme Court, at the city of Washington, D. C., on the 2d Monday of October, 1883, to do and receive what may appertain to justice in the premises.

Given under my hand, at the city of Hartford, in the district of Connecticut, in the 2d circuit, this 3d day of October, A. D. 1883.

N. SHIPMAN,
*One of the Judges of the Circuit Court of the U. S. for District of Connecticut.*

Due service of the foregoing citation is admitted.

JNO. S. BEACH,
*Solicitor for Appellee.*

[Endorsed:] U. S. circuit court, dist. of Connecticut. Hobart B. Ives *v.* Joseph B. Sargent. Citation on appeal.

8½ *The Return of the Judges of the Circuit Court of the United States for the District of Connecticut to the Foregoing Appeal.*

The record, proceedings, and judgment, whereof mention is therein made, follow in these words, viz:

HOBART B. IVES *v.* J. B. SARGENT.

Be it remembered that on the 15th day of May, 1882, there was filed in court a bill in equity in the words and figures following, viz:

9 United States Circuit Court, District of Connecticut.

HOBART B. IVES *vs.* J. B. SARGENT.

To the honorable the justices of the circuit court of the United States for the second circuit, within and for the district of Connecticut, sitting in equity:

Hobart B. Ives, of Fair Haven, in the town of New Haven, in said district of Connecticut, a citizen of the State of Connecticut and of the United States, brings this his bill of complaint against Joseph B. Sargent, of said New Haven, a citizen of this State of Connecticut and of the United States, and a resident within said district of Connecticut. And thereupon your orator complains and says that heretofore, to wit, on the 29th day of January, 1878, Frank Davis, then of North Adams, in the State of Massachusetts, was a citizen of the United States and was the original and first inventor of certain new and useful improvements in door-bolts, which improvements were not known or used prior to the invention thereof by said Davis; and said Davis did thereupon apply to the Commissioner of Patents of the United States for letters patent for said improvements; and upon his said application, he having fully complied with the requirements of law in connection therewith, the said Commis-

10 sioner of Patents did, on the 9th day of April, 1878, cause to be issued letters patent in the name and by the authority of the United States of America, whereby was granted to the said Frank Davis, his heirs, administrators, and assigns, for the term of seventeen years from the date thereof, the full and exclusive right and liberty of making, constructing, and vending to others to be used the said improvements, entitled in said patent "improvement in door-bolts," which letters patent were in all respects duly and legally issued and authenticated, dated April 9th, 1878, signed by the Secretary of the Interior of the United States, countersigned and sealed with the seal of the Patent Office by the Commissioner of Patents, and, having been duly recorded in the records of said office, were issued and delivered to the said Frank Davis, as by said letters patent or a duly certified copy thereof, ready to be shown in court if required, will appear.

And your orator shows that thereafter, to wit, on the — day of ——, 1879, the said Frank Davis did, by a certain valid instrument in writing, by him duly signed, sealed, and delivered, and recorded in the records of the Patent Office, sell, assign, and set over unto your orator, Hobart B. Ives, all the right, title, and interest of the said Frank Davis in and to said invention so covered and secured by said letters patent for, to, and in the whole of the said United States, including the district of Connecticut, and he, the said Ives, your orator, then became and still is the sole owner of said invention and said patent right and interests.

And your orator further shows that on the 1st day of April, 1881, your orator and the said Frank Davis having discovered that
11 said letters patent by reason of a defective and insufficient specification and claims were inoperative, which errors had arisen from inadvertency and mistake of said Davis and without any fraudulent or deceptive intention, the said Frank Davis did, by consent and request of your orator, and within a reasonable time after such discovery, present his petition to the Commissioner of Patents, in accordance with the statute in such case provided, setting forth and alleging the foregoing facts, and surrendered to said Commissioner said letters patent and fully complied with all the requirements of law in that behalf, and thereupon, to wit, on the 18th day of October, 1881, said Commissioner of Patents, having found the allegations of said petition to be true, did cancel said original letters patent and did cause new letters patent, under the authority and in the name of the United States, bearing said date, to be issued for said invention to said Hobart B. Ives (your orator) as assignee of said Davis, having an amended specification and claim wherein and whereby were secured in due form of law to Hobart B. Ives, his heirs, administrators, and assigns, for the remainder of the term of said original letters patent, the full and exclusive right and liberty of making, using, and vending the said improvement, the description whereof is contained in the specification attached to said reissued letters patent, which said reissued letters patent were in all respects duly and legally issued and authenticated, signed by the Secretary of the Interior of the United States, countersigned and sealed

with the seal of the Patent Office by the Commissioner of Patents, and, having been duly recorded, were issued and delivered to said Hobart B. Ives, your orator, as the assignee of said Frank
12 Davis, as by said reissued letters patent, or a duly certified copy thereof, ready in court to be produced if required, will more fully appear.

And your orator further shows that said reissue letters patent are still in full force, and that your orator is still the sole owner thereof and of all rights arising under the same, and is alone entitled to use and exercise within this district and elsewhere all the rights and privileges granted and secured thereby; and that the same are of great value to your orator and of great benefit to the public; and that in pursuance of said rights and privileges your orator has, since said reissue, made, used, and vended said improvement within this district and elsewhere.

And your orator further shows that since he became the owner of said invention as aforesaid, and since the reissue of said letters patent as aforesaid and up to the present time, the said Joseph B. Sargent, though well knowing the premises and your orator's rights, has, within this district of Connecticut and elsewhere, against your orator's consent, and notwithstanding his remonstrances and prohibitions, ever since the said reissue and down to the present time has been engaged, and still is, in the construction, sale, and use of bolts containing the inventions and improvements covered by the said reissue letters patent and secured by them to your orator, and that the said defendant refuses to desist from such infringement of your orator's rights, but continues the same and threatens to persist therein, and refuses to pay to your orator the damages occasioned to him thereby or the profits that accrue to said defendant by said infringement or any part thereof, although often requested and demanded; all which is contrary to equity and good conscience, and to the great damage of your orator, to wit, in the sum of
13 five thousand dollars, and that he must suffer great and irreparable injury unless relieved by the interposition of this honorable court.

To the end, therefore, that your orator may obtain adequate relief in the premises, may it please your honorable court to inquire into the allegations herein contained, and, on finding the same to be true, to order and decree that said defendant shall be enjoined and restrained from further infringing the rights of your orator under said reissue letters patent by the manufacture, sale, or use of the said patented improvement and invention, and that he shall render account of the number of bolts containing said improvement by him manufactured, used, or sold down to the time of such injunction and of the profits realized therefrom, and also that the damages sustained by your orator, and which he may be entitled to recover for the said unlawful acts of the defendant, may be ascertained, and the defendant ordered and decreed to pay the same and threefold the amount thereof, and also the costs and expenses of your orator in this list to be taxed.

And may it further please your honors to grant unto your orator

a subpœna directed to said Joseph B. Sargent commanding him to appear and answer fully and particularly to this bill of complaint and to abide such decree in the premises as shall be agreeable to equity and good conscience; and your orator, as in duty bound, will ever pray.

Dated at said New Haven this 13th day of May, 1882.

H. T. BLAKE,
*Solicitor and of Counsel for Complainant.*

14 UNITED STATES OF AMERICA, } ss:
*District of Connecticut,* }

NEW HAVEN, *May 15th*, 1882.

Then personally appeared the within-named Hobart B. Ives, the orator in the foregoing bill of complaint, and made solemn oath to the truth of the matters and allegations therein contained.

Before me,

_____.

And on the same day a writ of subpœna issued out of court directed to the said defendant, which was duly served and returned, and which, with the return of service endorsed thereon, is in the words and figures following, viz:

15 The President of the United States of America to the mar-
[SEAL.] shal of the district of Connecticut sendeth Greeting:

You are hereby commanded to summon Joseph B. Sargent, of New Haven, in the State and district of Connecticut, to appear before the judges of the circuit court of the United States of America for the district of Connecticut, in the second circuit, in equity, on the first Monday of June, 1882, wheresoever the said court shall then be, to answer a bill of complaint exhibited against said Joseph B. Sargent in said court by Hobart B. Ives, of said New Haven, in said State & district of Connecticut, and then and there to answer the same, and to do and abide by what said court may order and decree in the premises.

Make due service and return at least twenty days before said first Monday of June, 1882.

Witness the Hon. Morrison R. Waite, Chief Justice of the Supreme Court of the United States, at Hartford, this 15th day of May, A. D. 1882.

E. E. MARVIN, *Clerk.*

The defendant is required to enter his appearance in said cause in the clerk's office of said court on or before the day at which this writ is returnable, or, by the rules of said court, said bill will be taken as confessed.

E. E. MARVIN, *Clerk.*

H. T. BLAKE,
*Complainant's Solicitor.*

15½ UNITED STATES OF AMERICA.

DISTRICT OF CONNECTICUT, } ss:
*New Haven County,* }

NEW HAVEN, *May 16th*, 1882.

Then and there I served the within writ on Joseph B. Sargent, herein named, by delivering to and leaving with him a true and attested copy hereof.

Attest: GEORGE R. BILL,
*Deputy Marshal.*

Fees:

| | |
|---|---|
| Service | 2 00 |
| Copy | 1 00 |
| Travel | 3 80 |
| | $6 80 |

16 And on the same day H. T. Blake, Esq., entered his appearance for the complainant, and on the 18th day of May, 1882, J. S. Beach, Esq., entered his appearance for the respondent, and on the 30th day of June, 1882, respondent's answer was filed in the words and figures following, viz:

17 United States Circuit Court, District of Connecticut. In Equity.

HOBART B. IVES *vs.* J. B. SARGENT.

The answer of Joseph B. Sargent, defendant, to the bill of complaint of Hobart B. Ives, complainant.

The defendant, saving to himself all benefit of exception to the errors and uncertainties of said bill of complaint, for answer thereto, answering, says:

1. He is informed and believes that letters patent of the United States for improvements in door-bolts were, on the 9th day of April, 1878, issued to Frank Davis.

2. He has no knowledge of the alleged assignment of said letters patent to the complainant, and leaves the complainant to the proof thereof.

3. He is informed and believes that thereafter said original letters patent were surrendered, and that on the 18th day of October, 1881, other letters patent bearing that date, being No. 9901, were made out and delivered to the said Davis as assignor of the complainant, as reissued letters patent.

4. But the defendant denies that said original letters patent were so surrendered to the Commissioner of Patents for any good or lawful cause; on the contrary he avers that said surrender was
18 made for the purpose of claiming, by the reissue of said letters patent, inventions which were not claimed by said patentee in said original letters patent and which were not of his invention. And the defendant further avers that said original letters patent were not inoperative or invalid by any reason whatever, and that

said reissued letters patent have been granted for claimed inventions which are not the same as the invention shown in the original letters patent, and the claims of said original letters patent have been unlawfully broadened and expanded, so as to cover improvements in bolts not intended to be claimed in said original letters patent, and the defendant denies that said application for said reissued letters patent was made within a reasonable time after the said Davis or the said complainant discovered, or ought to have, said alleged mistake, and that they and each of them have been guilty of such laches in not sooner making application to the Commissioner of Patents for said reissue as to render the grant of the same inequitable and unlawful; and he further says that it fully appears upon the face of said original letters patent and of said reissued letters patent, when compared, that the Commissioner of Patents had no jurisdiction to grant said reissue No. 9901, and that the same is void and of no effect.

5. The defendant, upon information and belief, denies that the said Davis was the original and first inventor of the improvements patented to him in said letters patent, but avers that prior to his alleged invention the same had been described in the letters patent hereinafter mentioned, and that knowledge and use thereby, prior to the said alleged invention by said Davis, was had by persons and at the places hereinafter mentioned.

19 6. The defendant, further averring, denies that he has infringed upon any of the rights of said complainant under said reissued letters patent, and he denies that the said complainant is entitled to any relief in the premises, and he prays to be hence dismissed with his reasonable costs and charges in this behalf most wrongfully sustained.

JOSEPH B. SARGENT.

JOHN S. BEACH,
*Solicitor and of Counsel.*

STATE OF CONNECTICUT, }
*New Haven,* } *ss:* JUNE 29, 1882.

Personally appeared Joseph B. Sargent, who made oath that he has read the foregoing answer and knows the contents thereof, and that the same is true except as to those matters stated to be on information and belief, and as to those matters he believes them to be true.

JOHN K. BEACH,
*Notary Public.*

20 And on the 30th day of November, 1882, complainant's replication to said answer was filed in the words and figures following, viz:

DISTRICT OF CONNECTICUT, *ss:*

U. S. Circuit Court. In Equity.

HOBART B. IVES *v.* J. B. SARGENT.

The replication of the above-named complainant to the answer of the defendant.

This repliant, saving and reserving to himself all benefit of exceptions to said answer for insufficiencies, &c., replies that said bill of complaint is true and sufficient, and that said answer is untrue and insufficient, and therefore prays judgement, as in his petition is already set forth.

H. B. IVES,
*Complainant,*
By H. P. BLAKE,
*Solicitor.*

20½ And on the 25th day of April, 1883, complainant's and defendant's evidence *was* filed in the words and figures following, viz:

21 *Evidence for Complainant.*

United States Circuit Court, District of Connecticut. In Equity.

HOBART B. IVES *vs.* JOSEPH B. SARGENT.

Taken under and pursuant to the 67th rule of the Supreme Court of the United States, in equity, as amended, before John B. Mills, special examiner, pursuant to notice and by consent of parties.

NEW HAVEN, *March 3d*, 1883—11 o'clock a. m.

Present: Henry T. Blake, Esq., of counsel for complainant; John S. Beach, Esq., of counsel for defendant.

22 (Complainant puts in evidence the Patent Office copy of the original patent, dated April 9, 1878, No. 202,258, issued to Frank Davis, of North Adams, Mass., for an improvement in door-bolts, and the same is marked Complainant's Exhibit "Original Patent," J. B. Mills, Sp. Ex.

Also, reissued patent No. 9901, dated Oct. 18, 1881, issued to Frank Davis, of North Adams, Mass, assignor to Hobart B. Ives, of Fair Haven, Conn., and the same is marked Complainant's Exhibit "Reissued Patent," J. B. Mills, Sp. Ex.

Also, assignment by Frank Davis to Hobart B. Ives of said original patent and all reissues and extension thereof, dated 28th of May, 1879, recorded in Patent Office, June 2, 1879, and the same is marked Complainant's Exhibit "Assignment," J. B. Mills, Sp. Ex.)

*Deposition of Frank Davis.*

Direct examination by HENRY T. BLAKE, Esq., of counsel for complainant:

Interrogatory 1. What is your name, age, residence, and occupation?

Answer. Frank Davis; age, 40; residence, North Adams, Mass.; occupation, carpenter and builder.

Int. 2. In the year 1877 where did you reside?

Ans. Part of the time I was in New Haven; part of the time in North Adams. My home was in North Adams. I resided in New Haven in the fall of that year.

Int. 3. Are you the patentee named in the original patent, which has been put in evidence, and of which I now show you the exhibit copy?

23 Ans. Yes, sir.

Int. 4. Please state the circumstances under which you made that invention and applied for a patent.

(Defendant's counsel objects to the question as being irrelevant and incompetent, and it is agreed, to prevent the necessity of repeated objections to subsequent questions upon the same subject, that the questions and answers to be hereafter addressed to the witness are to be taken subject to the same objection without repetition.)

Ans. I was at work in Mr. Ives' shop, and saw that a pitman-spring was valuable to apply to a bolt and I applied for a patent through Mr. Geo. Terry to do it.

Int. 5. As I wish to get these facts more in detail than you are giving them I will inquire of you particularly, and first please state when you made this invention *first* which you so applied to have patented, and what the invention was.

Ans. In Nov., 1877. My invention was a pitman-spring to move a bolt in a case.

Int. 6. When you first made the invention to whom did you first speak of it and when?

Ans. To Mr. Ives, in November, 1877.

Int. 7. How soon after that did you determine to apply for a patent?

Ans. Soon after that, but did not apply for a patent until the last of January, 1878.

Int. 8. To whom did you go to make your application for a patent?

Ans. George Terry, patent solicitor, of New Haven.

Int. 9. Did you take with you a model containing your invention?

Ans. I did.

Int. 10. Please state how that model was made.

Ans. It was made of brass, and a zinc case; the zinc tube answered for a case and was the most convenient thing I could obtain for inclosing my invention.

Int. 11. State what the case was.

24 Ans. A zinc tube.

Int. 12. State what conversation you had with Mr. Terry, and what directions you gave Mr. Terry on applying for a patent on your invention.

Ans. I explained to Mr. Terry that I had got the spring, answering for a spring, and also for turning the bolt, a pitman-spring—I didn't know the term at that time.

Int. 13. What did you describe to him as the invention which you wished to have patented?

Ans. This pitman-spring and this guard, lever, and purchase that it had in holding the bolt out or back; also, in moving the bolt out and back.

Int. 14. State whether Mr. Terry took out your patent or not.

Ans. It was not his handwriting, and I should judge not.

Int. 15. At the time you made your application was anything said by him as to who would get it out?

Ans. Yes, sir; he told me that he had an agent in Washington who would do the business.

Int. 16. Where did you sign the application for the patent, when the application was completed and ready for your signature?

Ans. Mr. Terry's office.

Int. 17. When did you receive the patent after its issue by the office, and where were you and how did it come?

Ans. It was in April; I was in North Adams; it came by mail.

Int. 18. In what kind of an enclosure was it?

Ans. A square pasteboard envelope.

Int. 19. I omitted to ask you whether, when you signed the application in Mr. Terry's office, you examined it particularly, with reference more especially to the construction of the claims?

Ans. I did examine it and supposed it to be right, covering the spring which I intended to be patented.

Int. 20. Did you, before leaving New Haven for North Adams, or afterwards, dissolve your business relations with Mr. Ives, and, if so, was anything agreed as to the use of this invention by him thereafter?

25 Ans. Yes, sir; soon after I received my patent we dissolved. I think it was the 20th April, 1878, we dissolved, and I gave him permission to use this spring on another bolt which he already owned—written permission.

Int. 21. Have you any copy of that written agreement?

Ans. I have not. I never kept any.

(Witness is shown Exhibit Copy of the "Assignment," which has been put in evidence.)

Int. 22. Is that your signature?

Ans. Yes, sir.

Int. 23. Up to the date of that assignment who had possession of the patent papers?

Ans. I did.

Int. 24. Were they then delivered to Mr. Ives with the assignment?

Ans. They were.

Int. 25. When did you first hear that there was any trouble about the claims in that patent? State circumstances.

Ans. The winter of 1880, I am sure. Mr. Ives called my attention to it; brought a piece of a bolt with this spring attached to it, saying that there were parties infringing on him, but at that time didn't tell me what part. A month or two later I saw him again, and he told me that they were using that spring. I told him that no one had any right to use that spring, because it was the main thing in my last patent.

Int. 26. State whether he then or soon after brought you the application for this reissue. Give the date, if possible.

Ans. Our second interview; in April, I think. I think it was in 1880. I am not positive. It was after our first talk with regard to the infringement.

Int. 27. State whether you did execute the application for the reissue.

Ans. I did.

(The defendant's counsel, pursuant to the stipulation contained in his objection to Int. 1, now renews his objection to each and all of the foregoing questions and answers to the same effect as
26 if each question had been duly objected to, as calling for testimony irrelevant and incompetent, partly as being hearsay evidence, but principally because such testimony in support of the reissue is on its face not legally admissible as against the public or against this defendant, and he declines to cross-examine.)

(Cross-examination waived.)

FRANK DAVIS.

Attest:
JOHN B. MILLS, *Sp. Ex.*

*Deposition of Hobart B. Ives.*

Direct examination by HENRY T. BLAKE, of counsel for complainant:

Interrogatory 1. What is your name, age, residence, and occupation?

Answer. Hobart B. Ives; age, 39; residence, Fair Haven, Conn.; occupation, manufacturer.

Int. 2. You are complainant in this suit and assignee of the reissued patent, I suppose?

Ans. Yes, sir.

Int. 3. Please state your recollection of the circumstances when you first saw this invention patented in the fourth claim of the reissued patent.

(Defendant's counsel objects to the question as being irrelevant and incompetent, and it is agreed, to prevent the necessity of repeated objections to subsequent questions upon the same subject (which the complainant's counsel announces will relate to the same

topic as that to which the last witness, Frank Davis, was called), that the questions to be hereafter addressed to the witness are to be taken subject to the same objection without repetition.)

27 Ans. It was in the fall of 1877. Mr. Davis was working in my shop, and while there invented this pitman and spring, and brought it out and showed it to me. I was engaged in work, setting out some trees by my house.

Int. 4. Was anything said between you at that time about its being patented; if so, what?

Ans. He told me that he was going to get it patented.

Int. 5. What were you engaged in manufacturing at that time?

Ans. We had a door-bolt, previously patented, or rather the case was patented. We were engaged perfecting that case for that bolt, which brought about this invention.

Int. 6. Was that case the same case as represented in this original patent?

Ans. It was not.

Int. 7. How soon after you saw this invention of Davis' did you begin to make them or use it?

Ans. It might have been a year.

Int. 8. Can you fix the date when you first began to use this pitman-spring?

Ans. I have it, of course, but can't fix the date here.

Int. 9. When you did begin to use it; in what sort of a case did you use it?

Ans. In the one patented May 8, 1877.

Int. 10. Was it the same kind of a case as is represented in the original Davis patent, or have you ever made any in that kind of a case?

Ans. It was not, and there have no cases been made after the Davis patent; I mean like it—not subsequent to it.

Int. 11. Please identify the case, which in your last answer you say you have never made any like it.

Ans. I mean a case within a case, as shown in the original patent, No. 202,158, patented April 9th, 1878, to Frank Davis.

Int. 12. Did you receive from Mr. Davis any written agreement or license with reference to the use of his invention, prior to the assignment to you which is in evidence?

Ans. I did.

Int. 13. Have you that written agreement here?

Ans. I have not.

28 Int. 14. Where is it?

Ans. I failed to find it. I have searched for it and failed to find it. It is probably mislaid among my papers.

Int. 15. Please state when the license was given, as nearly as you can.

Ans. In the spring of 1878.

Int. 16. Who drew it?

Ans. I think George Terry.

Int. 17. What invention did that license authorize you to use?

Ans. It gave me the use of that pitman-spring and hub as long as the patent had to run.

Int. 18. Had you seen his patent at that time?

A. I don't think I had.

Int. 19. When was the first time that you remember to have seen it?

Ans. About a year afterwards I bought the entire patent and then I think I read the patent over, but couldn't say positively that I did then.

Int. 20. When did you first discover that there was any trouble in the claims of the patent with regard to the pitman-spring?

Ans. The latter part of the year 1880.

Int. 21. What led you to that discovery?

Ans. I was told by one of my polishers that they saw a bolt or bolts—they should think the same article—in Sargent's shop in the course of the manufacture. I learned afterwards they were on the market.

Int. 21. How did that lead to the discovery that there was any trouble in your claims?

Ans. As soon as I heard or found out that Sargent was using my pitman-spring I consulted Mr. George Terry in reference to my patent. He examined it, and for the first time then I learned from him that that pitman-spring was not held by itself in the patent, and he advised a reissue, which I immediately applied for as soon as I could get the proper papers from Davis to do so. My reissue was allowed, a copy of which I mailed to Mr. Sargent or Sargent & Co.

Recess until 2 p. m.

29 Examination resumed 2 p. m.

Int. 22. While the patent was in your possession, after its assignment to you by Mr. Davis and before you consulted Mr. Terry, as you stated in your last answer, did you examine it or read it?

Ans. Yes; I examined it and read it—both.

Int. 23. How is it that you did not discover that the pitman-spring was not covered as a separate invention if you did not, in fact, discover it?

Ans. I suppose it was from examining the drawings. I could see plainly the pitman, the lug, and the hub. My knowledge of patents at that time was very limited, and the fact that that was shown so clear in the drawings I thought was sufficient.

Int. 24. Did you before going to see Mr. Terry make a sale of bolts which you were making containing the pitman-spring to Mr. Sargent? If so, give the date and other particulars of the transaction.

Ans. I did; August 18, 1880, he sent to my shop for a dozen door-bolts; I delivered them to his man, sent him an invoice through the mail; him or Sargent & Co.; the bill was brought into my office after a time with the money to pay for them; I receipted the bill and gave him credit for the money.

Int. 25. What were those bolts enclosed in as they were delivered and sent to Sargent & Co.?

Ans. In a box that holds a dozen.

Int. 26. Was the box labelled, and, if so, was "patent" marked on the label?

Ans. The box was labelled, "Ives' patent burglar-proof door-bolts," and the date of the patent, April 9, 1878, was printed on the box.

Int. 27. Since you sent Mr. Sargent the copy of your reissued patent, as you stated in a former answer, have you had an interview with him in respect to your claim of infringement?

Ans. I have had several.

Int. 28. Did you explain to Mr. Sargent or not the claim in your reissued patent which you conceived to be infringed by him?

30 Ans. I did.

Int. 29. What was Mr. Sargent's reply with reference to your claim of infringement; did he admit or deny making the pitman-spring which you claimed to be covered by your patent?

Ans. At first he didn't give me a direct answer; said he didn't know much about it; he said they sent a bolt up to him from New York and wanted them to make some; he said they were taking pretty well in the market; I pointed out to him that he was using my pitman-spring, and he finally admitted that he was using a spring like mine, but would not give me much satisfaction; as I was leaving his office he called me back, took out my original patent from a drawer close by—a copy of it—and commenced to argue the case with me that I had no valid patent; he cited the Miller *vs.* Bridgeport Brass Co. case, and said reissues were good for nothing; I asked him what they were for; he said they were to deceive the public; but as I was about to leave his office he said he would look into it a little or more fully, or something of that kind; I received a letter from him with reference to the matter, of six pages.

Int. 30. When was this interview that you have spoken of at his office; can you give the date of it; the first interview; how long after you sent him the copy of the reissued patent, as nearly as you can tell?

Ans. It was as soon as I learned that he was still making the bolts, which was in a month or two after I sent him the reissue.

Int. 31. Have you had an interview with him since on the same subject?

Ans. I had the second one a few weeks afterwards; he still claimed that when I surrendered my patent I lost it entirely.

Int. 32. Did he say anything then about his having made or intending to make the spring pitman in cylindrical door-bolts?

Ans. He said that they had used it; to what extent he didn't know; he hadn't paid much attention to it; he said that they should use that pitman-spring; if I wanted to sue him to go ahead.

31 Int. 33. Have you a sample here of the door-bolt which you are making, which includes the pitman-spring covered by your reissued patent?

Ans. I have.

(The sample produced is put in evidence by complainant and marked Complainant's Exhibit "Ives Bolt," J. B. Mills, Sp. Ex.)

Int. 34. Did the bolts which you sold to Mr. Sargent in August, 1880, resemble this, or were they different?

Ans. They resembled that.

(Defendant's counsel, pursuant to the stipulation contained in his objection to Int. 1, now renews his objection, and each and all of the foregoing questions (except Int. 33), to the same effect as if each question had been duly objected to as irrelevant and as calling for testimony incompetent, as being in part hearsay evidence, but principally because such testimony, in support of the reissued letters patent, is inadmissible as against the public or against this defendant.)

Cross-examination waived.

HOBART B. IVES.

Attest: JOHN B. MILLS, *Sp. Ex.*

(Examined adjourned until Saturday, March 10, 1883, at 11 o'clock a. m.)

32 Examination resumed:

*Deposition of Joseph D. Mansfield.*

NEW HAVEN, CONN., *Mar.* 10, 1883—10 o'clock a. m.

Direct examination by HENRY T. BLAKE, Esq., of counsel for complainant:

Interrogatory 1. What is your name, age, residence, and occupation?

Answer. Joseph D. Mansfield; age, 28; residence, New Haven, Conn.; occupation, salesman of hardware for F. S. Bradley & Co.

Int. 2. What was your occupation in the early part of the year 1882?

Ans. Salesman for the same concern, F. S. Bradley & Co.

Int. 3. Did you, in the month of March or April, 1882, make a purchase of door-bolts from J. B. Sargent & Co?

Ans. I did make such purchase.

Int. 4. Can you give the date of that purchase and a particular description of the goods bought?

Ans. Referring to the bill, the date was March 22, 1882, and the goods were known as mortise bolts No. 298.

Int. 5. Were the bolts contained in any box or enclosure?

Ans. The bolts were put up in a green box labeled, as all their goods are, with the concern's name.

Int. 6. Do you see any box here of the same character as that in which the bolts you bought were enclosed?

Ans. This box.

(The box referred to by the witness is put in evidence by complainant's counsel and it is marked Complainant's Exhibit "Sargent Bolt Box," J. B. Mills, Sp. Ex.)

Int. 7. Will you describe the label, if there was any, on that box?
Ans. It was similar to the one now on this box.
33 Int. 8. Will you please open the box and state what kind of bolts were enclosed in the box when you made this purchase from Sargent & Co.?
Ans. The bolt now in the box is similar to the bolts with which the box was filled.

(The bolt referred to by the witness is put in evidence by complainant's counsel and it is marked Complainant's Exhibit Sargent Bolt," J. B. Mills, Sp. Ex.)

Int. 9. Is this the bill which you received from Sargent & Co. containing the item of these bolts?
Ans. It is.

(The bill recognized by the witness is put in evidence by complainant's counsel, and the same is marked Complainant's Exhibit "Bill for Bolts," J B. Mills, Sp. Ex)

Int. 10. Are you acquainted with the firm of Sargent & Co.?
Ans. I am in a business way.
Int. 11. Who is the managing man of the concern?
Ans. J. B. Sargent, I suppose.

(No cross-examination.)

JOSEPH D. MANSFIELD.

Attest: JOHN B. MILLS, *Sp. Ex.*

*Deposition of George Terry.*

Direct examination by HENRY T. BLAKE, Esq., of counsel for complainant:

Interrogatory 1. What is your name, age, residence, and occupation?
Answer. George Terry; age, 67; residence, New Haven, Conn.; occupation, solicitor of patents.
Int. 2. How long have you been a solicitor of patents in New Haven?
34 Ans. Twelve years.
Int. 3. Please look at the exhibit marked "Original Patent" filed in this case, dated April 9, 1878, issued to Frank Davis, and state whether you know said Frank Davis, and also whether you knew of the circumstances attending his application for that patent. If so, give particulars.

(Defendant's counsel objects to the question as being irrelevant and incompetent, and it is agreed that to prevent the necessity of repeated objections to subsequent questions upon the same subject that the questions to be hereafter addressed to the witness are to be taken to the same objection without repetition thereof.)

Ans. In answer I would say that I am acquainted with the Frank Davis; that he brought the invention or bolt to me and stated that

he wanted to get it patented. He also stated what his invention was, as he considered it, that he wanted patented, and the thing that he wanted patented particularly was the pitman or connecting rod which answered the double purpose of pitman and spring and in connection with the crank held the bolt when it was shoved out of the case and when it was drawn within the case. At this time, and for three or four months previous, I had not done any business in soliciting patents on account of ill health, and with Mr. Davis' consent I sent this case to my agent or associate in Washington, W. F. Babcock, to be prepared by him. I sent a letter of instructions with the model setting forth Mr. Davis' wishes as he had expressed them to me. In due time the papers were prepared and sent to me. I notified Mr. Davis, and he came to my office, signed the papers, and made oath to the invention, and I returned them to Mr. Babcock, in Washington.

Int. 4. Did you read over the specifications and examine the claims at the time Mr. Davis signed the papers?

Ans. I don't recollect that I did.

Int. 5. Who received the patent when it was issued?

Ans. The office sent the patent to W. F. Babcock; he forwarded the patent to me, and, without opening the envelope, I redirected it and sent it to Mr. Davis, North Adams, Mass.

Int. 6. What was the next business that you had with Mr. Davis or Mr. Ives, or both, in connection with said patent?

Ans. Soon after this patent of April 9, 1878, was issued, I drew a license which gave to Mr. Ives the right to use the pitman-spring during the lifetime of the patent, Mr. Ives and myself then supposing that this pitman-spring was claimed in the patent of April 9, 1878.

Int. 7. Did you have the patent before you, or a copy of it, when the license was drawn?

Ans. I did not.

Int. 8. Have you a copy of that license in your possession?

Ans. I have not; never kept a copy of it.

Int. 9. Can you tell the date of it pretty nearly?

Ans. I have no way to fix the date of drawing that license other than by the patent of April 9, 1878, and I believe that the license was drawn soon after that patent was issued.

Int. 10. What was the next business, if anything, that you had in connection with this patent?

Ans. Mr. Ives called on me a short time prior to the application for the reissue and represented that parties were infringing the patent of 1878 and were using the pitman, which performed the double function of pitman and spring. After some conversation with him I requested him to bring to me the patent of April 9, 1878, and I told him that I would look it over and see exactly what the patent did claim. He brought the patent to me and I examined it and advised a reissue, as the patent did not embrace a claim for the pitman operating as a spring, as he and I had both supposed it did until that examination.

Int. 11. What did Mr. Ives say in reply to this?

Ans. He directed me to make application for a reissue, which I did.

Int. 12. Please look at the exhibit filed in this case and marked "Complainant's Reissue," and state whether that is a copy of the reissue patent which you obtained for Mr. Ives?

Ans. It is.

36 (Defendant's counsel, pursuant to the stipulation contained in his objection to Int. 1, now renews his objection to each and all of the foregoing questions and answers to the same effect as if each question had been duly objected to, as calling for testimony irrelevant and incompetent, partly as being hearsay evidence, partly as parol evidence of *the evidence of* the contents of existing written documents, but principally because such testimony in support of the reissue is on its face not legally admissible as against the public or as against this defendant.)

Int. 13. Please look at this bolt, marked Complainant's Exhibit "Sargent's Bolt," and state, as an expert in mechanical constructions, whether you find any feature in it which infringes a claim of the reissue patent in question, and, if so, specify what it is.

Ans. I find in this bolt, as it is called, that the bolt proper is provided with a hole into which one end of the pitman is inserted, which comes under a lug on the bolt, the other end of the spring being inserted in a circular disk, which I consider the mechanical equivalent of the crank D in the reissue patent, and that this construction is a direct infringement of the third claim in the reissue patent.

I also find that the pitman in this bolt is arranged and adapted to operate as a pitman and spring, and is a direct infringement of the fourth claim of the reissue patent.

(No cross-examination.)

GEORGE TERRY.

Attest: JOHN B. MILLS, *Sp. Ex.*

37 *Deposition of Hobart B. Ives when Recalled by Complainant.*

Direct examination by HENRY T. BLAKE, Esq., of counsel for complainant:

Interrogatory 1. Have you made search for the written license from Davis to you which was referred to in your previous examination, and with what success?

Answer. I have again made search for the license given me by Davis to use the pitman-spring, and have failed to find it.

Int. 2. Have you any idea where it is or whether it is in existence anywhere?

Ans. I have none.

(No cross-examination.)

HOBART B. IVES.

Attest: JOHN B. MILLS, *Sp. Ex.*

(Complainant rests.)

38 United States Circuit Court, District of Connecticut. In Equity.

HOBART B. IVES *vs.* JOSEPH B. SARGENT.

I, John B. Mills, by consent of parties, special examiner in the above-entitled cause, do certify that the foregoing depositions were taken before me on the days in the body of said depositions named, to be used on the part of the complainant in the above-entitled suit; that said depositions were reduced to writing by me in the presence of and from the statements of the witnesses who subscribed said depositions and in the presence of the counsel for the respective parties.

That the witnesses were duly cautioned and sworn and subscribed the said depositions before me.

That I am not of counsel or attorney for either of the parties in said depositions and caption named, or in any way interested in the event of said cause named in said caption.

In testimony whereof I have hereunto set my hand this 10th day of March, 1883.

JOHN B. MILLS,
*Special Examiner.*

39 *Evidence for Defendant.*

United States Circuit Court, District of Connecticut. In Equity.

HOBART B. IVES *vs.* JOSEPH B. SARGENT.

Taken under and pursuant to the 67th rule of the Supreme Court of the United States in equity, as amended, before John B. Mills, special examiner, pursuant to notice and by consent of parties.

NEW HAVEN, CONNECTICUT, *April* 16, 1883—2 o'clock p. m.

Present: Henry T. Blake, Esq., of counsel for complainant; John S. Beach, Esq., of counsel for defendant.

40 *Deposition of Purmont Bradford.*

Direct examination by Mr. BEACH:

Interrogatory 1. What is your name, age, and residence?

Answer. Purmont Bradford; age, 64; residence, New Haven, Conn.

Int. 2. How long have you been in the employment of Sargent & Co., of New Haven?

Ans. Ever since the corporation was formed.

Int. 3. And about when was the date of that?

Ans. Fall of 1864.

Int. 4. In what capacity have you been so employed?

Ans. Superintendent.

Int. 5. Have you had anything to do with the pattern department; and, if so, what?

Ans. I have; superintending it.

Int. 6. Look at Complainant's Exhibit "Sargent Bolt" and say when you made the patterns for that bolt.

Ans. I commenced to work on them Sept. 4, 1880; it was finished in November of the same year.

Int. 7. How soon after the patterns were finished was the manufacture of such bolts begun by Sargent & Co. for the market?

Ans. Made the first lot Dec. 1, 1880.

Int. 8. Look at Complainant's Exhibit "Original Patent" and say whether or no Sargent & Co. ever made casings for bolts such as are there shown—that is, having a cylindrical exterior casing combined with an inner casing.

Ans. They never did.

Cross-examination by Mr. BLAKE:

Cr.-int. 9. Who is the head of the manufacturing business and the managing director of it—of Sargent & Co.?

Ans. J. B. Sargent, the president of the corporation.

PURMONT BRADFORD.

Attest: JOHN B. MILLS, *Sp. Ex.*

41 United States Circuit Court, District of Connecticut. In Equity.

HOBART B. IVES *vs.* JOSEPH B. SARGENT.

I, John B. Mills, by consent of parties, special examiner in the above-entitled cause, do certify that the foregoing deposition was taken before me on the 16th day of April, 1883, to be used on the part of the defendant in the above-entitled suit; that said deposition was reduced to writing by me in the presence of and from the statements of the witness who subscribed said deposition, and in the presence of the counsel for the respective parties.

That the witness was duly cautioned and sworn, and subscribed the said deposition before me.

That I am not of counsel or attorney for either of the parties in said deposition and caption named, or in any way interested in the event of said cause

In testimony whereof I have hereunto set my hand this 16th day of April, 1883.

JOHN B. MILLS,
*Special Examiner.*

41½ And at the term of said court held at New Haven on the fourth Tuesday of April, 1883, the plaintiff, by Henry T. Blake, Esq., duly appeared, and the defendant, by John S. Beach, Esq., also appeared, and said cause was fully heard.

And on the 23d day of July, 1883, the court filed its opinion in the words and figures following, viz:

42 Circuit Court of the United States for the District of Connecticut.

HOBART B. IVES *v.* JOSEPH B. SARGENT.

SHIPMAN, *J.*:

This is a bill in equity to restrain the defendant from the alleged infringement of reissued letters patent, dated October 18th, 1881, to the plaintiff as assignee of Frank Davis, for an improvement in door-bolts. The original patent was granted to Davis as inventor on April 9th, 1878, and the application for a reissue was filed April 1st, 1881.

The specification of the reissue says that the invention consisted "in combining a cylindrical outer case with an inner case, constructed and recessed as hereinafter described, said cases combining to inclose the operating mechanism, and to form a fulcrum, and guide therefor; in combining with said cases a bolt, pitman and crank; and in a pitman or connecting rod performing the
43 functions of both pitman and spring, as the above are hereinafter more fully set forth and claimed."

The pitman which performed the functions of both pitman and spring was in fact the essence of the invention and is claimed alone, and, in combination with the bolt and crank to hold the bolt in the third and fourth claims of the reissue, as follows:

"3. The combination of the bolt C, provided with the lug *c*, pitman E, operating as a pitman and spring, and crank D, to hold the bolt, substantially as set forth.

"4. In a cylindrical door-bolt, the pitman E, arranged and adapted to operate as a pitman and spring, substantially as set forth."

In the original specification the patentee was made to say that his invention consisted "chiefly in combining a cylindrical outer casing, constructed and recessed as hereinafter described, said casings combining to inclose the operating mechanism, and to form a fulcrum and guide therefor, and in combining with said casings a bolt, pitman, and hub, so constructed and arranged as to
44 operate in the same without pivot pins or any additional devices, all as hereinafter more fully described and claimed."

The second of the three claims of the original patent and the only one which mentioned the pitman was as follows:

"2. The combination of casing A, having opposite holes *a a*, with inner casing B, having transverse groove $b^6$ and slot $b^7$, flat hub D, having crank arm D′, and the bolt and pitman, substantially as set forth."

It is manifest that the draughtsman had no idea that the pitman-spring uncombined with the two casings was to be claimed or was regarded as a distinctive part of the invention.

The defendant, as president and head of the manufacturing business of the corporation known as "Sargent & Co.," is infringing the third and fourth claims only of the reissue, but has not infringed either claim of the original patent.

The defense is that the 3d and 4th claims of the reissue are
45 not for the invention described or claimed in the original patent and are therefore void.

The inventor, a carpenter by trade and not an educated man, invented the device in November, 1877, and applied in January, 1878, to Mr. Terry, a patent solicitor in New Haven, to procure him a patent, specifying as the invention to be patented, the pitman which, in connection with the crank, held the bolt and answered the double purpose of pitman and spring. Terry, being in ill health and therefore not then doing business, sent the case to his agent in Washington, with Davis' instructions. In due time the papers were returned to Terry and were signed by Davis, who read them and supposed that the application "covered the spring which he intended to be patented." Terry did not read the application. The patent was received by Davis in April, 1878. It does not appear whether it was then examined or not. The plaintiff did not see the patent until after it was assigned to him on May 28th, 1879; whether he then read it or not he does not know, but in the latter part of 1880, after the defendant had begun to infringe, he did read it and sup-
46 posed from the drawings that the pitman-spring as a separate invention was secured by the patent until he was undeceived by Mr. Terry. In the spring of 1878 the plaintiff received from Davis a license to use the pitman-spring upon another than the patented bolt.

In September, 1880, Sargent & Co. commenced work upon the patterns for the infringing bolt, and made the first bolts December 1st, 1880.

The plaintiff insists that the invention of the pitman acting also as a spring, independent of its connection with the casings, is shown in the specification of the original patent, and that therefore the correction of the mistake by the introduction of a proper claim was not new matter.

The defendant claims that there is no hint in the original patent that the pitman was to have the function of a spring, but if there had been a full description of it, yet, as there was no suggestion that the pitman-spring could accomplish a beneficial result disconnected from the two casings, the reissue contained a different
47 invention from any which was suggested in the original specification, and therefore the invention of the 3d and 4th claims is new matter. It seems to me that it is useless to discuss this question, because, if the alleged mistake could have been safely and permanently corrected by seasonable application to the Patent Office, the patentee and assignee had at the time of the application for a reissue lost their rights by their own laches.

The Supreme Court, in Miller *v.* Brass Co'y, 104 U. S., 350, declared that the right to have a mistake in a patent corrected, when the mistake was plain and forthwith discernible and improperly narrowed the claim, must be speedily exercised, and that the right would be necessarily abandoned and lost by unreasonable delay.

The Court said: "In reference to reissues made for the purpose of enlarging the scope of the patent, the rule of laches should be

strictly applied, and no one should be relieved who has slept upon his rights and has thus led the public to rely on the implied disclaimer involved in the terms of the original patent." This doctrine of the loss through laches of the right which a patentee
48 would otherwise have had to correct mistakes has been favorably referred to by the Supreme Court in at least four cases since the decision of Miller *v.* Brass Co'y.

In this case the mistake which is claimed to have occurred in consequence of the draughtsman's failure to know the nature of the invention was one which a person conversant with the invention and with the subject of patents would have seen upon the first inspection of the application or of the patent. The inventor read the application, but, reading with intelligent eyes, did not perceive that his invention was not attempted to be secured. He made no inquiries of the intelligent solicitor who witnessed his signature to the application, but returned the papers to Washington. The assignee took a license or permission to use the pitman-spring in the spring of 1878, and afterwards bought the patent without ever having read it, and cannot say positively that he examined it until after the infringement.

The patent was issued April 9th, 1878, and on Dec. 1st,
49 1880, two years and seven months afterwards, the defendant, who probably had read it, commenced to make non-infringing bolts.

It would be useless to suggest that the plaintiff moved with alacrity after he knew of the defect in his patent, and that the patentee's ignorance was an excuse for his inefficiency, for the palpable negligence of the one in buying a patent without knowing or reading its contents and the ignorance of the other, when knowledge was at hand, do not bar the consequences of delay. Quoting the language of the Supreme Court in regard to laches respecting claims or rights which did not pertain to patents, "It is not merely a question as to what information respecting their rights parties do actually obtain, but as to what information they might have obtained had they used, the means and opportunities directly at their command." Hoyt *v.* Sprague, 103 U. S., 613. It is obvious that the present case is one of hardship to an honest purchaser of a patent, but the Supreme Court, after having repeatedly declared, in substance, that reissues with enlarged claims are to be the exception and not the rule, in
50 the recent cases say that the "rule of laches should be strictly applied," and that it is too late for the inventor to regain an exclusive right in his invention, when, after a delay which is unreasonable if men are to be required in the matter of their patents to act with ordinary prudence and promptness, the thing invented has gone into public use and individuals are expending money in its manufacture.

The bill is dismissed.

HENRY T. BLAKE,
*For the Plaintiff.*
JOHN S. BEACH,
*For the Defendant.*

51 And on the 2d day of October, 1883, the following final decree was made and entered in said cause, viz:

At a stated term of the circuit court of the United States, in and for the district of Connecticut, on the 4th Tuesday of April, A. D. 1883. In Equity.

Present: Hon. Nath'l Shipman, judge.

HOBART B. IVES *v.* JOSEPH B. SARGENT.

This cause came on for final hearing upon the pleadings and proofs of parties, and was fully argued before the court by the counsel for the respective parties, and upon such hearing and due consideration had it is hereby ordered, adjudged, and decreed that the reissued letters patent in suit No. 9901 granted to Frank Davis, as assignor to Hobart B. Ives, the complainant, and dated October 18, 1881, are void.

It is therefore ordered and adjudged that said complaint be dismissed, and that the defendant recover his costs, taxed and allowed at the sum of forty-one & $\frac{80}{100}$ dollars

Dated Hartford this 1st day of October, 1883.

N. SHIPMAN, *Judge.*

52 I, Edwin E. Marvin, clerk of the circuit court of the United States for the district of Connecticut, do certify that the foregoing is a true copy of the original record in this court.

In testimony whereof I have hereunto set my hand and the seal of said court, at Hartford, in said district, this 4th day of October, A. D. 1883.

[Seal of Circuit Court, Connecticut.]

EDWIN E. MARVIN, *Clerk.*

Endorsed on cover: Connecticut C. C. U. S. No. 94. Hobart B. Ives, appellant, *vs.* Joseph B. Sargent. Filed 6th October, 1883.

119-652

SUPREME COURT U.S.
FILED
NOV 9 1886
JAMES H. MCKENNEY
CLERK

# Supreme Court of the United States.

OCTOBER TERM, 1886.

HOBART B. IVES
*vs.*
JOSEPH B. SARGENT. } *IN EQUITY.*

COMPLAINANT'S APPEAL FROM THE U. S. CIRCUIT COURT FOR THE DISTRICT OF CONNECTICUT.

## BRIEF OF H. T. BLAKE,

*Counsel for Complainant.*

NEW HAVEN:
TUTTLE, MOREHOUSE & TAYLOR, PRINTERS.
1886.

# Supreme Court of the United States.

OCTOBER TERM, 1886.

HOBART B. IVES, *Appellant*,
*vs.*
JOSEPH B. SARGENT, *Appellee*. } IN EQUITY.

In this case there is no conflict of testimony, and but a single question at issue. The evidence shows a re-issue patent with an enlarged claim applied for nearly three years after the date of the original, and reasons for the delay. The only question in the case is, Is the re-issue patent valid? Infringement is not controverted.

## The Pleadings.

The **bill** gives the dates of the original and re-issue patents. It does not show when the *application* for the re-issue was made, though it avers it to have been "within a reasonable time;" nor does it show whether the re-issue was broader or narrower than the original patent. The **answer** denies the validity of the re-issue patent on the ground, among others alleged, that its "claims have been unlawfully broadened," and also that "it was not applied for in a reasonable time." But as neither the bill nor the answer sets out or recites any part of either patent, there are not sufficient facts disclosed on the face of the pleadings upon which to predicate the questions of law in controversy. It becomes necessary, therefore, to refer to the evidence, and as to the facts of the case there is no dispute or question.

**The original and re-issue patents compared.**

The first item of evidence is the patents themselves. The original patent was granted to Frank Davis for an "improvement in door locks," April 9, 1878. The re-issue patent was granted to Frank Davis, assignor to Hobart B. Ives (the complainant), October 18, 1881. The application was filed April 1, 1881, not quite three years after the date of the original patent.

**No new matter introduced into the re-issue.**

Upon comparing the two patents it will be seen at once that no new matter is introduced into the descriptive part of the re-issue specification. Everything described or shown therein is also described and shown in the original patent. The drawings and model are the same in both cases. The only expansion is found in the claims, and relates to the device shown in fig. 3 of both patents. This device (referred to throughout the testimony as **"the pitman spring device"**), consists essentially of a wire *E*, so arranged on the bolt *C* in connection with the crank *D* and the lower pin *c* as to perform the double function of pitman and spring in throwing and holding the bolt. In the original patent it is covered (by claim 2) in combination with the outer and inner casings of the bolt. In the re-issue (by claims 3 and 4) it is covered independently of the casings.

**In the original patent** this device is not only shown as a distinct invention in fig. 3 of the drawings, but it is also repeatedly referred to as such in the specification.

**In the third paragraph** "the nature of the invention" is described as consisting chiefly in combining certain described casings with "the operating mechanism" which is enclosed therein; the casings forming merely "a fulcrum and guide" to the operating mechanism. The said "operating mechanism" is then described as "a bolt, pitman and hub so arranged as to operate in the same (said casings) without pivot pins or any additional devices." As the only "additional device" usual

in such cases is a spring, the sentence may be paraphrased thus: "The pitman is so constructed and arranged in connection with the bolt and the hub (or crank) as to require no separate pivot pins and no separate spring." To show how this new simplicity is secured, reference is made to the drawings and subsequent parts of the patent.

Thus, **in the fourth paragaph,** "Fig. 3 is a detail view of the bolt and its attachments." On referring to fig. 3 the attachment of the wire pitman to the hub and bolt by its bent ends without pivot pins, and its action as a spring against the lower pin *c*, are clearly depicted. Were it possible, however, to misunderstand the drawing, the model would correct any such mistake, and leave no room to misapprehend the double function of the wire as pitman and spring in moving the bolt.

**In the eighth paragraph,** pursuing the reference to fig. 3, the elements of the device as a distinct invention are further specified. "*C* designates the door bolt, having guide pins *c* on its side, and near its rear end a recess *C'*, in which works the lower end of crank arm *D'*, formed in one piece with flat hub *D*. Said lower end of crank arm *D'* is connected by pitman *E* to the front part of said bolt."

**In claims 1 and 3** the casings are again mentioned as mere receptacles for "the bolt and working mechanism," and "forming a fulcrum and guide therefor:" thus again identifying these two sets of devices as distinct and separate inventions.

**By claim 2** all these features are grouped together as follows: "The combination of casing *A* having opposite holes *a*, *a*, with inner casing *B* having transverse groove $b^6$ and slot $b^7$, *flat hub D having crank arm D', and the bolt and pitman substantially as set forth.*"

**the re-issue patent** the descriptive part of the specification is to some extent re-cast, but introduces no feature not shown and described in the original patent. The drawings are the same, the parts described are the same, their functions and operation are the same, and the only real difference is that the double function of wire *E* as pitman and spring is more fully explained and dwelt on.

**In lines 16, 17,** the wire *E* is referred to as "a pitman or connecting rod, performing the functions of both pitman and spring."

**In lines 61 to 70** the description is more detailed. "The pitman and spring *E* (fig. 3) is a straight, hard drawn wire and is connected to the bolt and crank by suitable pivotal connections. As shown in the drawings, its ends are bent at right angles to its length, and pass into holes in the bolt and crank, the spring being made long enough for the purpose. The lug *c* on the bolt is so arranged relative to the connections of the spring as to give it the required degree of tension or 'set up,' as it is called. The tension bends the spring over the lug *c*, as shown in fig. 3."

**Claims 1 and 2** are the same as 1 and 3 in the original patent. Claim 2 of the original is dropped, and in its place the following are substituted.

"3. The combination of the bolt *C* provided with lug *c*, pitman *E* operating as a pitman and spring, and crank *D* to hold the bolt substantially as set forth.

4. In a cylindrical door bolt the pitman *E*, arranged and adapted to operate as a pitman and spring substantially as set forth."

That the devices covered by the last two claims of the re-issue patent were new and actually invented by Davis, and might have been properly embraced in his original patent, is not disputed. The allowance of the re-issue patent is in itself an evidence of these facts. Why they were not so embraced it now remains to consider.

## History of the Patents.

The following facts are disclosed by the testimony. The original patentee Davis, a carpenter by trade, whose home was in Massachusetts, invented the device shown in fig. 3, while working in complainant Ives' shop in New Haven, Connecticut. Davis saw that the invention as a simple and economical substitute in a door bolt for the usual pitman and spring arrangement was valuable, spoke of it as such to his employer Ives, and

determined to apply for a patent upon it (Record, pp. 10, 13). In order to show its operation he made the model of a complete door bolt, using a zinc tube as "the most convenient thing for inclosing the invention" (Record p. 10, Int. 10). He then took his model to a Patent solicitor in New Haven of standing and experience (see p. 17, fol. 34), Mr. George Terry, and explained to him the device which he wished to have patented. On this point Davis testified as follows: (see Record, p. 11).

*Int.* 12. State what conversation you had with Mr. Terry and what directions you gave Mr. Terry on applying for a patent on your invention?

*Ans.* I explained to Mr. Terry that I had got the spring answering for a spring and also for turning the bolt, a pitman-spring, I didn't know the term at that time.

*Int.* 13. What did you describe to him as the invention which you wished to have patented?

*Ans.* This pitman-spring, and this guard, lever and purchase that it had in holding the bolt out or back; also in moving the bolt out and back.

Terry's testimony on this point is equally explicit (Record, p. 17–18).

*Ans.* In answer I would say that I am acquainted with Frank Davis; that he brought the invention or bolt to me and stated that he wanted to get it patented. He also stated what his invention was as he considered it that he wanted patented, and the thing that he wanted patented particularly was the pitman or connecting rod which answered the double purpose of pitman and spring and in connection with the crank held the bolt when it was shoved out of the case and when it was drawn within the case.

Terry being in ill-health at this time felt unable to take full charge of the business, and with the acquiescence of Davis sent it to his correspondent Patent solicitor in Washington, and also sent (in his own words) "a letter of instructions with the model, setting forth Mr. Davis' wishes as he had expressed them to me" (Record p. 18, lines 10, 11).

In due time the prepared application was received by Terry from Washington. He notified Davis, who called at his office, read over and examined the papers and supposing them to be correct and in conformity with his instructions signed them and made the requisite oath. Terry then returned them to the Washington solicitor.

Davis' statement on this point is unequivocal (Record, p. 11).

"*Int.* 19. I omitted to ask you whether when you signed the application in Mr. Terry's office you examined it particularly, more especially with reference to the construction of the claims?

*Ans.* I did examine it and supposed it to be right, covering the spring which I intended to be patented."

Unfortunately for him his counsel had not been equally vigilant (see Record, p. 18, Terry's deposition).

"*Int.* 4. Did you read over the specifications and examine the claims at the time Mr. Davis signed the papers?

*Ans.* I don't recollect that I did."

In the full belief that his counsel had obeyed his instructions and that his application had been drawn so as to "cover the spring which he intended to be patented." Davis returned to his home in North Adams. The patent was issued April 9th, and sent to Terry who forwarded it to Davis at North Adams without taking it out of the envelope (Record, p. 18, fol. 35).

## Ives' license and purchase.

In the meantime the complainant Ives had come to an arrangement with Davis for the use of the pitman-spring device *in a different form of casing* which he was then making (p. 11, Int. 20). Within a few days after the patent was issued (April 20) Ives employed Terry to draw a license for such use. Terry says (Record, p. 18, fol. 35):

"Soon after this patent of April 9, 1878, was issued, I drew a license which gave to Mr. Ives the right to use the pitman-spring during the lifetime of the patent. Mr. Ives and myself then supposing that this pitman-spring was claimed in the patent of April 9, 1878.

*Int.* 7. Did you have the patent before you or a copy of it when the license was drawn?

*Ans.* I did not.

The patent remained at North Adams in possession of Davis until May 28, 1879. So fully persuaded was he during all this period and long afterwards that the pitman-spring device was separately covered by it that when Ives told him early in 1881 that other parties were using that device, he exclaimed that "no one had a right to use that spring because it was the main thing in his patent" (Record, p. 12, Int. 25). Meanwhile Ives had been manufacturing bolts at New Haven, using the pitman-spring under his license in his own form of outside casing, and by May, 1882, he had so far developed a market for his bolts that he decided to purchase the patent. That the exclusive use of the pitman-spring was the sole inducement to this purchase is manifest from the fact that Ives was not using, and never had used and never intended to use the casing shown in the Davis patent. In fact he testifies that no casing like that shown in the patent was ever made except the single one which Davis made out of an old zinc tube for his patent model (Record, p. 13, Int. 10).

The assignment of the patent having been drawn by Terry, and the purchase completed, the patent now came for the first time under Ives' observation. He thinks he read it over then, but is not sure (Record, p. 14, Int. 19). He does, however, remember and states explicitly that he "read it over and examined it both," either then or at some later time, before he consulted Terry about its supposed infringement. Whether his first perusal of it was immediately after his purchase or somewhat later is of little consequence, because when he did read it, he failed, like Davis, to discover anything in its language or claims which excited any doubt of its sufficiency (Record, p. 14, Int. 22).

"*Int.* 22. While the patent was in your possession after its assignment to you by Mr. Davis and before you consulted Mr. Terry as you stated in your last answer, did you examine it or read it?

*Ans.* Yes, I examined it and read it, both.

*Int.* 23. How is it that you did not discover that the pitman-spring was not covered as a separate invention, if you did not in fact discover it?

*Ans.* I suppose it was from examining the drawings. I could see plainly the pitman, the lug, and the hub. My knowledge of patents at that time was very limited and the fact that it was shown so clear in the drawings I thought was sufficient."

So little did he apprehend or suspect any weakness in his patent that when he afterwards went to consult Terry about its supposed infringement, he neglected to take it with him. Terry says (Record, p. 18, Ans. to Int. 10):

"Mr. Ives called on me a short time prior to the application for the re-issue, and represented that parties were infringing the patent of 1878, and were using the pitman which performed the double function of pitman and spring. After some conversation with him I requested him to bring to me the patent of April 9, 1878, and I told him that I would look it over and see exactly what the patent did claim. He brought the patent to me and I examined it and advised a re-issue as the patent did not embrace a claim for the pitman operating as a spring as he and I had both supposed it did until that examination."

*Int.* 11. What did Mr. Ives say in reply to this?

*Ans.* He directed me to make application for a re-issue, which I did.

Ives testifies to the same effect (Record, p. 14, Ans. to Int. 21):

"As soon as I heard or found out that Sargent was using my pitman-spring, I consulted Mr. Geo. Terry in reference to my patent. He examined it and then for the first time I learned from him that the pitman-spring was not held by itself in the patent, and he advised a re-issue, which I immediately applied for as soon as I could get the proper papers from Davis to do so. My re-issue was allowed, a copy of which I mailed to Mr. Sargent or Sargent & Co."

**The Case shows a clear intention, an honest ignorance, and an honest re-issue.**

In reviewing the above facts (which are undisputed,) it is evident that both Davis and Ives honestly intended from the outset to have the pitman-spring device separately covered by the original patent, and were honestly ignorant that it was not. That this ignorance was greatly prejudicial to their interests is of itself proof that it was genuine. Had Davis discovered the defect when he read over the application before signing, he would have seen that unless it was corrected Ives would be little likely to pay for a license, still less to buy the patent. Had Ives suspected it either when he took his license or when afterwards he "read the patent over and examined it both," he would have at once have refrained or desisted from investing money and labor in an unprotected manufacture.

**Nor did their ignorance arise from indifference.** They were both alive to the importance of this special feature. Both of them consulted and instructed and paid competent counsel with special reference to its security. They both relied upon it, and both scrutinized the patent to see that it was embodied there. They did not sleep on their rights. They were wide awake, and rested easy only because they believed their rights to have been duly protected. Their confidence was that which arises from the consciousness of diligence exercised. It certainly did not spring from apathy or neglect.

**No "later improvements" taken in.**

It is also true that they have not made this ignorance a cover for subsequent bad faith. In this application for a re-issue there has been no attempt to expand the patent beyond the actual original invention, and no attempt to appropriate the ideas or improvements of subsequent inventors. The defendant does not pretend that he or any one else has added anything to the Davis invention which this re-issue attempts to appropriate or suppress. In fact as will be seen on inspection the defendant's bolt is simply a reproduction of the Ives bolt. Not only the pitman-spring device but the casing also which

is covered by another patent is identically reproduced. The explanation of this similarity appears from the evidence. The defendant did not commence the manufacture of these bolts until Ives, by over two years of labor and expense, had built up a market for them. At that time their popularity had attracted the attention of defendant's agents in New York, and they sent him one of Ives' bolts, requesting him to commence their manufacture (Record, p. 15, Int. 29). Defendant sent at once to Ives' shop (August 18, 1880), and bought a dozen bolts duly labelled and marked with the date of the patent (Record, p. 14, Int. 24, 25). From these he made his patterns in exact reproduction, and in the course of a few months was in the market which Ives had made, as his competitor. According to his own account he found this market a good one (Record, p. 15, Int. 29), and should the re-issue patent be sustained, doubtless the profits of the ten month's sales for which defendant will not be legally accountable, will fully indemnify him for his originality, enterprise, and expense in getting up these facsimile patterns.

**Where does "laches" appear?**

If there was laches involved in this honest ignorance of Davis and Ives, it must be found at some point where they failed to use "that reasonable degree of care which is habitual to and expected of men in the management of their own interests in the ordinary affairs of life" (*Wollensak vs. Reiher*, 115 U. S. 99). Where does such failure appear? Was it in a neglect to secure competent legal assistance in procuring the original patent? No, for Davis did employ reputable counsel of long experience and unquestionably competent, for as soon as he inspected the patent he saw its defect and correctly drew the specification for the re issue. Was there any failure to instruct their counsel properly as to the actual invention? No, for Davis explicitly told him that the pitman spring was the device which he wished to have specially secured. Did they or either of them neglect to examine the patent for themselves, and by such neglect fail to discover a defect which might have been obvious to them upon inspection? No, for both

of them read the patent over and examined it with reference to the very question whether the pitman spring device was properly secured, and both though erroneously, through an honest ignorance, came to the conclusion that it was. Nor was the mistake entirely unaccountable. The explanation of Ives is a natural one. He saw the pitman spring device plainly shown by itself in the drawings and his "acquaintance with patents being very limited," supposed it to be equally individualized by the legal construction of the specification and claims. It must be noticed that the device in its entirety is itself a combination, and a combination claim (like claim 3 in the re-issue patent) is a proper, and perhaps the best form of claim to cover it. The mistake therefore (or as our opponents contend, the laches) of Davis and Ives consists not in failing to discover that the second claim of the original patent was a combination claim, **but in failing to distinguish between a combination claim that legally secured the invention and one that did not.**

On this point the language of the Court below in its opinion seems hardly consistent with the evidence or with its own conclusions.

The learned Judge remarks (Record, p. 24, fol. 48): "The mistake which is claimed to have occurred . . . . was one which a person conversant with the invention and with the subject of patents would have seen upon the first inspection of the application or of the patent. The inventor read the application, but reading with [un]intelligent* eyes did not perceive that his invention was not attempted to be secured. He made no inquiries of the intelligent solicitor who witnessed his signature to the application but returned the papers to Washington."

The evidence is that Davis read the patent over with reference to his invention, and thought that it was secured. It had been handed to him by his counsel for signature, as being correct and

* Mis-printed "intelligent" in the Record.

according to his instructions. He saw no reason to doubt that it was so. There was therefore nothing to put him upon inquiry. His Honor surely did not intend to impute blame or unreasonable neglect to Davis because "reading with unintelligent eyes," he "did not perceive" a legal construction which "a person conversant with patents" would have seen on inspection. As well charge a color-blind man with negligence because he cannot distinguish tints which are plain to an expert, or an unlearned man for not correctly translating a passage in a foreign language which a scholar comprehends at sight. Had Davis and Ives been foreigners imperfectly acquainted with the English language, their failure to discern the defect of their patent would have been considered explained and excusable. Is it any less so when it arose from ignorance or inexperience? To the uneducated layman a legal instrument seems in a sort of foreign tongue, just as a physician's prescription is a foreign language to those who are not versed in medical technicalities. Such a person must trust to his counsel to draw a legal paper in accordance with his instructions; and if these have been explicit and fully understood, he is reasonably justified and even compelled to suppose that the document is correctly drawn when presented to him for signature. Such is the course of prudent men in the ordinary transactions of life. Who catechises a reputable physician as to whether he has properly drawn a prescription, or an experienced druggist as to whether he has not made a mistake in compounding it? What learned lawyer or judge, though his life may be at stake, scrutinizes and tests the mixture before he swallows it? But if he should in fact do so, and if after testing it fully by what little medical knowledge he had and finding it apparently right, he should be fatally poisoned after all, it would hardly be a reasonable verdict for the coronor's jury to find that he "Died through his own inexcusable negligence in not cross-examining the doctor and the druggist."

These remarks apply to Ives as well as Davis and perhaps more strongly. The patent was issued April 9, 1878, and

eleven days later (April 20, 1878) when Ives desired a license to be drawn, giving him the use of the pitman spring device under it, he employed Terry who had just procured it as counsel, and who might well be supposed to be conversant with its terms so far as to know whether that device was secured as "the main thing in the patent." That Terry acting as counsel for Ives drew the license without hesitation, was in itself a professional assurance that the pitman spring was so secured, and was available to him as an independent feature. It is not unlikely that he may have told him so (though of this there is no positive proof), for Terry says that he then supposed it to be the case. (See Record, p. 18, Int. 6, Terry's deposition).

"Soon after this patent of April 8, 1878, was issued, I drew a license which gave to Mr. Ives the right to use the pitman spring during the life-time of the patent, Mr. Ives and myself then supposing that this pitman spring was claimed in the patent of April 9, 1878."

His Honor below remarks that Ives took out the license without reading the patent. But in fact the patent was then in North Adams; and as Ives wanted only the use of this single device, for which as he supposed the patent had just been specially granted, and as the whole matter was then so fresh in Terry's mind, there seemed to be no reason for sending for the patent unless Terry wanted it, which he did not. The license must also have gone to North Adams for the signature of Davis who had the patent in his possession, and who at least would be likely to know whether its terms would support the license. When the latter therefore came back duly executed by Davis, Ives had the double assurance and practical warranty, both of counsel and patentee, that the patent fully covered the special feature of the pitman spring arrangement. It is not strange then that with this double guarantee he felt perfectly secure and that a year afterwards, having meantime used that invention without question or interference by any one, he determined to buy the patent and did so. His Honor finds negligence here because "he bought the patent without ever having read it and cannot say positively that he examined it till after the infringement." The evidence is that Ives be-

lieves he read the patent immediately on its purchase, but that he certainly did at *some* time before he consulted Terry about its supposed infringement (Record, p. 14, Int. 19, 22). It may have been months before; but if it were in fact after the defendant's use of the pitman spring device had come to his knowledge, and if he then referred to his patent with an attention sharpened by anxiety to see whether everything was in fact safe, and under the pressure of that anxiety "examined it, and read it both," it is certain that even then he failed to discover its defect, but still supposed the pitman spring to be covered, and had so little suspicion to the contrary that when he went to consult Terry about the infringement he did not take the patent with him (Record, p. 18, Int. 10).

**It is easy to be wise after the event.** It is easy to see now that if Davis before he signed the application, had not only read it, but had been suspicious of it, and had questioned his intelligent solicitor as to whether he and his associate had not both disobeyed their instructions and grossly neglected their duty, the mistake would probably have been then discovered. But was his failure to do so, not seeing any occasion for it, such an unreasonable disregard of ordinary prudence that he ought to be forever after debarred from remedy or excuse? And so with Ives. Doubtless it would have been better for him if he had placed no confidence in Terry's professional warranty or in Davis' endorsement by his signature to the license, that the pitman spring device was the main thing in the patent. Even when he read the patent over himself and seemed to find everything in accordance with his counsel's and Davis' opinion, doubtless it would have been better if he had felt instinctively and acted upon the supposition that nevertheless the patent was insufficient although he could see no reason to suppose so. But if thus trusting to his counsel was an unreasonable neglect, suppose in the next case of this kind that comes before this Court, it shall appear that ignorant clients have set up their own judgments or instincts against the advice of competent counsel and have happened to be wrong, will their excessive caution be accepted as reasonable excuse for their blunders? And if in any point of view the omis-

sions of Davis and Ives to suspect their counsel's professional fidelity or judgment are chargeable against them as errors, are they errors so great and unreasonable that we may not fairly invoke that "liberality toward the patentee," which this Court declares in *Mahn vs. Harwood* (112 U. S. 354), the courts may always be trusted to display? **If, as this court has repeatedly remarked, there may be cases in which a delay of over two years may be explained, is one likely to ever occur more meritorious in all its aspects than the case at bar?**

**The laches was on the part of the solicitors.**

The court below in its opinion says nothing of any negligence on the part of the solicitors, although it was this which created the whole trouble. It was the Washington solicitor's disobedience to instructions which caused the mistake, and Terry's neglect to revise the application before sending for Davis to sign it, which prevented its discovery. The real question in the case is, therefore, whether the neglect by a lawyer of his client's cause constitutes unreasonable laches on the part of the client.

No doubt there are cases where the acts or knowledge of counsel are regarded as the acts or knowledge of the client, but these are cases where the lawyer is acting within the scope of his employment. If he is acting outside of that employment, if he is doing that which he was instructed not to do, or not doing that which he was employed and directed to do, it would seem unreasonable to hold the client liable as a participator in his negligence or disobedience. Herein the case at bar differs from that of *Arnheim vs. Finster*, 24 Fed. Rep. 276; 26 Id. 277, and similar cases. In that case a broad claim in the original application had been rejected by the patent office with the acquiescence of the solicitor. The patentee, according to his own story, did not know of the rejection, and supposed that the broad claim was in the patent until he read the patent over for the first time nearly two years afterwards, and then instantly discovered its absence. The patentee in that case was justly held responsible for not making earlier use of such intelligence and discernment as he had.

That case, as also *Mahn vs. Harwood*, *Leggett vs. Avery* (101 U. S. 259) and others also differ from the case at bar in the circumstance that there was in fact no inadvertence, accident or mistake in the omission of the broad claim from the original patent. It had been asked for and rejected, and abandoned by acquiescence in the rejection.

In the following case, where the attorney had neglected to file an application as directed by the inventor, it was held that "the client should not be made to suffer for the neglect of his attorney. *Howes vs. McNeal*, 3 Banning and Arden, 376. See also *Birdsall vs. McDonald*, 1 Ban. and Ard. 165.

In the case of *Adams vs. Jones*, 1 Fisher, 529, by Grier, J., it was said "involuntary delays, the mistakes of public officers, or the delays of court, not caused by the laches of the applicant, should not work a forfeiture of his rights." So in *Sayles vs. Chicago & N. W. R. R. Co.*, 2 Fisher, 523, where the application owing to insufficient specification and drawings lay suspended from 1847 to 1852 in the patent office, the court (Drummond, J.) held that there had been no intentional abandonment or neglect by the inventors through this delay of the Patent Office to act on the application. The general rule is that "delay will not operate as a bar so long as the party remains without any fault of his own in ignorance of his rights and injuries." *Stanhope's case*, L. R., 1 Chan. App. Cas.; *Charters vs. Trevelyan*, 11 Cl. and Finn. 714.

In *Stutz vs. Armstrong*, 20 Fed. Rep. 843, Acheson, J., held that nothing should be predicated against the inventor through the acquiescence of his solicitor in the rejection of the broad claim, when such acquiescence arose from the solicitor's misunderstanding of the nature of the invention; the inventor being of foreign speech, and so possibly "not having been able fully to explain the matter.

## Analogous reformations of mistakes in written instruments.

In *Mahn vs. Harwood*, (112 U. S. p. 354), the court remarks that the purpose of the statute of re-issues "undoubtedly was to provide that kind of relief which courts of equity have always

given in cases of clear accident and mistake in the drawing of written instruments." In any such case, undoubtedly, reasonable diligence in seeking reformation is requisite lest the equities of the applicant should have become in the meantime offset by greater equities on the part of particular individuals or the public, and in any such application the reasonableness of the applicant's claim would be tested in part at least by a comparison of his equities with those of these adverse parties. Let us suggest an illustration :

A discovers on his land a valuable mineral and B agrees to purchase an exclusive license to open and develop the mine. Both parties are foreigners by birth, uneducated and imperfectly acquainted with the English language. By the carelessness of counsel the papers are so drawn as to amount in legal effect to a general license to the public, a mistake which the parties through ignorance fail to detect. The license is executed and placed on record, and under it B spends over two years of labor and expense in opening the mine and developing a market. At the end of this period, just as his business is beginning to be profitable, C appears at the mine with laborers and commences operations as B's competitor. This leads to a discovery of the mistake in the deed, and a joint petition is at once brought by A and B to the proper court for its reformation. After several months delay the petition is granted and the deed reformed. Meantime C has had uninterrupted and profitable use of the mine and the market, and now refuses to retire notwithstanding the reformation of the deed. B applies for an injunction against his further labor, and C defends on the ground that B lost his right to have the deed corrected by his failure sooner to discover its defects.

In such a case we submit that the court would hardly set aside the decree of reformation as invalid unless it should clearly appear that the equities of C and the public were so superior to those of B that it would be a hardship and injustice toward them to sustain it. And in weighing the question whether such injustice was liable to be done, the court would be apt to estimate the situations of all the parties and their relative claims upon the consideration of the court. Such we understand to be the bearing of the decisions of this court in re-

issue cases protecting the just rights of later inventors, and in view of its care in this direction we cannot but believe that it would be slow to inflict upon fair-minded and meritorious patentees, in a case of clear mistake, the heavy penalty of confiscation for the benefit of competitors who have no special claims and are liable to suffer little if any loss or inconvenience.

**The validity of sub-combination claims.**

A discussion arose on the argument in the court below which is thus referred to in the opinion of the court. (Record, p. 23, fol. 47):

"The defendant claims that there is no hint in the original patent that the pitman was to have the function of a spring, but if there had been a full description of it, yet, as there was no suggestion that the pitman spring could accomplish a beneficial result disconnected from the two casings the reissue contained a different invention from any which was suggested in the original specification, and therefore the insertion of the 3d and 4th claims is new matter."

That the original patent did clearly show by its drawings, model and specification the double function of pitman and spring, and did repeatedly refer to the whole device as "the operating mechanism," as distinguished from the outer casings "forming a fulcrum or guide therefor," we have already shown in another part of this brief. The contention of the learned counsel therefore, as above stated by the court, and as set out more definitely in his printed brief below, was to the effect that independently of all questions of laches, inadvertence or mistake, "the claims of a re-issue patent cannot be lawfully expanded to cover the separate elements of a combination claim in the original." In support of this proposition the learned counsel cited *Miller vs. Brass Co.*, *Banz vs. Franz*, 105 U. S. 160, *Matthews vs. Machine Co.*, 105 U. S. 54. *Johnson vs. Railroad Co.*, 105 U. S. 539, and other cases.

The argument rests on a failure to discriminate between the cases cited in which the ingredients of the combination *were all old*, and so the invention described in the original consisted in

the general combination only—and those cases in which, as in the case at bar, some or all of the ingredients were *new*, constituting separable inventions distinct from and independent of the general combination. Of the former class were all the cases above referred to, and notably *Gill vs. Wells*, which was the forerunner of them all. In these cases this court held that no invention being described or suggested in the original patent except a certain combination of old ingredients, the attempt to claim in the reissue a different combination of the same old ingredients as the invention, was the introduction of new matter.

But of the latter class, those in which some of the ingredients or devices were *new*, though claimed in a general combination only, if these new ingredients or devices were found described and clearly shown in the specifications, drawings or models of the original patent, there are numerous cases in which this court and the Circuit Courts have held that such distinct inventions may be segregated from the combination and made the subject of a re-issue "in order to give effect to the real invention." Such are the cases of *Battin vs. Taggert*, (17 Howard R. 74), where the original patent was for a combined coal breaker and screen, and the reissue for the coal breaker only. *Smith vs. Merriam*, (6 Fed. Rep. 713) where the original claim was for a presser foot and folder in combination, and the reissue was granted for the presser foot alone. *Crandall vs. Watters*, (20 Blatch. R., 97), where the original patent covered a combined box-loop and plate, and the reissue the box-loop without the plate. See also the following cases and many others equally decisive on this point.

*Parham vs. Am. Button hole Co.*, 4 Fisher 468.
*Pearl vs. Ocean Mills*, 2 Bann & Ard. 469.
*Herring vs. Nelson*, 3 Bann & Ard. 55.
*Gallahue vs. Butterfield*, 10 Blatch. R. 237.
*Graham vs. McCormick*, 11 Fed. Rep. 859.
*Asmer vs. Alden*, 27 Fed. Rep. 684.

In all the cases discovered, where sub-combination claims in a re-issue patent have been set aside, it has been either on the ground of laches, or that of no inadvertence, accident or mis-

take in the original patent. Thus in *Swain Turbine Co. vs. Ladd*, (102 U. S. 403), this court found only a special form of water wheel described in the original as a part of the combination, while the reissue sought 12 years later to stretch the combination so as to include all other forms of wheel whatever. The court in this case held that the patentee was limited by the invention as originally described and shown in his patent specification and drawings, and remark as follows: "In a clear case of mistake, not error in judgment, the patent may undoubtedly be enlarged, but that should be the exception, not the rule, whereas the enlargement of claims has become the rule and their contraction the exception." The principle is that the claims may sometimes be expanded, but the invention never.

**Indeed the patent law itself (Sect 4916),** whenever the thing patented is composed of "distinct and separate parts," authorizes the original patent to be re-issued in several patents corresponding with the severally patentable parts of the general combination. This authority, of course, applies to sub-combinations as well as to single devices, and the whole section leaves it optional with the patentee whether in such cases he will take his segregation in the form of several patents or in the form of several claims in the same patent. Of course, in these, as in all other cases, the reissue patents must be otherwise valid, but if so the objection of "new matter," or "different invention," will not avail on the ground that "the claims have been so expanded as to cover the separate elements of a combination claim in the original."

In the Case of *Stevens vs. Pritchard*, 2 Bann. and Ard. 390, Mr. Justice Clifford remarks on this subject:

"Separate descriptions of the respective inventions in one application are as good as if made in several applications, but the claims must be separate. And it would follow that if the patentee by inadvertence, accident or mistake should fail to claim any one of the described combinations, he might surrender the original patent, and have a re-issue not only for the combination claimed in the original specification, but for any which were so omitted in the claims of the original patent."

It may be proper to suggest, in closing, that the occurrence of this discussion on the legal qualities of combination claims in a patent, and upon which the court below refrains from expressing an opinion, additionally illustrates the propriety of extending a liberal consideration to uneducated men who fail to discover mistakes in their patents, especially when these have been as they suppose carefully drawn and revised by competent counsel.

HENRY T. BLAKE,
*Counsel for Complainant.*

119-652

# Supreme Court of the United States.

OCTOBER TERM, 1886.

HOBERT B. IVES, *Appellant*,
*vs.*
JOSEPH B. SARGENT, *Appellee*.
} No. 94.

## Appeal from the Circuit Court of the United States for the District of Connecticut.

## BRIEF OF APPELLEE.

JOHN S. BEACH,
*Counsel for Appellee.*

Hoggson & Robinson, Law Printers, New Haven.

# Supreme Court of the United States.

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HOBERT B. IVES, *Appellant*,
*vs.*
JOSEPH B. SARGENT, *Appellee*. } No. 94.

## Appeal from the Circuit Court of the United States for the District of Connecticut.

## BRIEF OF APPELLEE.

### STATEMENT.

The suit is for the supposed infringement of exclusive rights of the appellant, under the 3d and 4th claims of Letters Patent, reissued to the appellant as the assignee of Frank Davis, for an "improvement in door-bolts."

Those claims read:

3d. The combination of the bolt C, provided with the

lug c, pitman E, operating as a pitman and spring, and crank D to hold the bolt, substantially as set forth.

4th. In a cylindrical door-bolt, the pitman E, arranged and adapted to operate as a pitman and spring, substantially as set forth.

The original patent, which contained no suggestion of either of these claims, was granted and dated April 9th, 1878.

The appellant became the owner of the original patent by purchase from the patentee, in May, 1879.

The reissue was applied for April 1st, 1881, and was granted and dated October 18th, 1881.

The avowed object of the appellant in his application for a reissue, was so to expand the claims of the original patent as to include therein, a door-bolt (being the appellees alleged infringement), then, and for months prior thereto, on sale in the market.

This is admitted by the appellant.

Int. 20. "When did you first discover that there was any trouble in the claims of the patent with regard to the pitman-spring?

Ans. The latter part of the year 1880.

Int. 21. What led you to that discovery?

Ans. I was told by one of my polishers that they saw a bolt or bolts—they should think the same article—in Sargent's shop in the course of manufacture. I learned afterward they were on the market.

Int. 22. How did that lead to the discovery that there was any trouble in your claims?

Ans. As soon as I heard, or found out that Sargent was

using my pitman-spring, I consulted Mr. George Terry in reference to my patent. He examined it, and for the first time I then learned from him that that pitman-spring was not held by itself in the patent, and he advised a reissue, which I immediately applied for as soon as I could get the proper papers from Davis to do so. My reissue was allowed, a copy of which I mailed to Mr. Sargent, or Sargent & Co.

Record, page 14, folio 28.

The differences between the specification and claims of the original patent, and those of the reissue, will be seen by comparing the two side by side.

So much of the original as is excluded from the reissue, is included in [ ] and the additions of the reissue are italicized.

Specification forming part of Letters Patent No. 202,158, dated April 9, 1878.

ANNOUNCEMENT OF INVENTION.

*To all whom it may concern:*

Be it known that I, FRANK DAVIS, of North Adams, in the county of Berkshire and State of Massachusetts, have invented certain new and useful Improvements in Door-Bolts; and I do hereby declare that the following is a [full, clear, and ex-

Specification forming part of Reissued Letters Patent No. 9,901, dated October 18, 1881. Original No. 202,158, dated April 9, 1878. Application for reissue dated April 1, 1881.

ANNOUNCEMENT OF INVENTION.

*To all whom it may concern:*

Be it known that I, FRANK DAVIS, of North Adams, in the county of Berkshire and State of Massachusetts, have invented certain new and useful Improvements in Door-Bolts, of which the following is a description.

act] description [of my invention, which will enable others skilled in the art to which it appertains to make and use the same, reference being had to the accompanying drawings, and to letters of reference marked thereon, which form a part of this specification.]

This invention is an improvement on Letters Patent No. 190,561, granted to the undersigned May 8, 1877.

The improvements are on the door-bolt for which Letters Patent were granted to me May 8, 1877.

## Nature of the Invention.

The [nature of said] invention consists, [chiefly,] in combining a cylindrical outer casing with an inner casing, constructed and recessed as hereinafter described, said casings combining to inclose the operating mechanism, and to form a fulcrum and guide therefor; [and] in combining, with said casings, a bolt, pitman, and [hub, so constructed and arranged as to operate in the same without pivot-pins or any additional devices all as] hereinafter more fully described and claimed.

## Nature of the Invention.

The invention consists in combining a cylindrical outer case with an inner case, constructed and recessed as hereinafter described, said cases combining to inclose the operating mechanism, and to form a fulcrum and guide therefor; in combining with said cases a bolt, pitman, and *crank; and in a pitman or connecting rod performing the functions of both pitman and spring as the above are* hereinafter more fully set forth and claimed.

## Explanation of Drawings.

In the accompanying drawings Fig. 1 [represents the device as a whole] in perspective.

## Explanation of Drawings.

In the accompanying drawings, Figure 1 *shows the bolt* in perspective. Fig. 2 is a per-

Fig. 2 represents a perspective view of the inner casing [and contents.] Fig. 3 is a [detail] view of the bolt [and its attachments]. Fig. 4 is a detail view of the inner casing. Fig. 5 is a detail view of the outer casing.

DESCRIPTION OF MECHANISM.

[A designates a cylindrical metallic outer casing or sleeve, which is provided with opposite openings *a a* near its rear end, and with a hole, $a^1$, for attachment by means of screw $a^2$ to inner casing B.

It is obvious that any known equivalent fastening may be substituted for said screw. Said casing A is preferably a mere shell of steel, but both the material and thickness can be considerably varied without departing from my invention.

Inner casing B is of brass, cast-iron, or other cheap metal, and has such diameter as allows it to pass readily into said outer casing or sleeve, and to be conveniently withdrawn therefrom. It is provided at the front end with a disk, which has a central opening, *b*, for the passage of the bolt, and an annular

spective view of the inner case *and portions of some of the working parts*. Fig. 3 is a view of the bolt, *spring, and crank*. Fig. 4 is a detail view of the inner case, and Fig. 5 is a detail view of the outer case.

*To enable others to make and use my improvements in door-bolts, I will describe them in detail.*

DESCRIPTION OF MECHANISM.

*A, Figs.* 1 *and* 5, *is a cylindrical metallic outer case, having the holes* a a *near its rear end, and hole* a', *through which a screw,* $a^2$, *Fig.* 1, *passes into the inner case, B, to hold the two cases together. The inner cylindrical case, B, Figs.* 2 *and* 4, *is made to fit closely into the outer case, and has on its front end a disk in which is the central opening,* b. *On its front end the flange* b', *is formed, against which the outer case comes. A slot,* $b^3$, *Fig.* 4, *extends from the disk on the front end the whole length of the case. Another slot,* $b^3$, *opposite the slot* $b^2$, *extends backward from the end disk, as shown in Fig.* 4. *These slots leave the parts* $b^4$ $b^4$ *of the inner case,* as *shown in Fig.* 4. *A groove,* $b^6$, *extends across the case between the parts* $b^5$ *and* $b^5$ *of the case. A longi-*

flange, $b^1$, which prevents it from being forced back too far within said exterior casing. The bottom of said inner casing B has a broad longitudinal slot, $b^2$, extending from end to end, and communicating with a similar longitudinal slot, $b^3$, in the top of said casing B, which extends about two-thirds of the length of said casing, beginning just behind said front disk. The interior of the forward part of said inner casing is thus entirely removed, leaving vertical walls $b^4$ $b^4$ on each side of the space thus produced. This space is separated by a transverse partition, $b^5$, from a transverse groove, $b^6$, in the bottom of which is a longitudinal slot, $b^7$. A transverse partition, $b^8$, at the rear of said groove and slot, forms part of the rear end of casing B, and has in its top a screw-threaded hole or socket $b^9$, for the reception of fastening screw $a^2$.

C designates the door-bolt, having guide-pins c on its side, and near its rear end a recess, $c'$, in which works the lower end of crank-arm D', formed in one piece with flat hub D. Said lower end of crank-arm D' is connected by pitman E to the front part of said bolt. Said hub D, when in position for use, extends up through said slot $b^7$, *tudinal slot*, $b^7$, *bisects this groove and is cut through the case.*

*C, Fig. 3, is the bolt, made with the lugs* c c, *only one of which is used. The projecting end is round, the part within the case is rectangular, one of the narrower sides fitting into the slot* $b^2$, *and the other into* $b^3$. *Its rear end is made narrower and thinner to make room for the crank, as shown in Fig.* 3.

*The crank D is made in the usual form, and is arranged in a position to bring the hole through its larger end in line with the groove* $b^6$ *on the inner case and with the openings* a a *in the outer case.*

*The pitman and spring E, Fig.* 3, *is a straight hard-drawn wire, and is connected to the bolt and crank by suitable pivotal connections. As shown in the drawings, its ends are bent at right angles to its length and pass into holes in the bolt and crank, the spring being made long enough for the purpose. The lug* c *on the bolt is so arranged relative to the connections of the spring as to give it the required degree of tension or "set up," as it is called. The tension bends the spring over the lug* c, *as shown in Fig.* 3. *The key has its shank square to fit the hole in the crank, with a round part near the handle to*

so that its square or similarly-shaped central hole is in a line with transverse groove *b** of inner casing B, and opposite holes *a a* of outer casing A. The prismatic shank of the key is passed through said holes and groove, and operated as usual to shoot or draw the bolt.

I do not confine myself to the exact details of construction shown, as these may be somewhat modified in various ways without departing from the spirit of my invention.

The working parts of my mechanism are more firmly secured and more perfectly protected than in my former patent, as hereinbefore recited. I also deem the shape of my new hub and crank preferable for practical working.]

CLAIMS.

Having thus described my [invention] what I claim as new and desire to protect by Letters Patent, is—

1. The combination, with a door-bolt and operating mechanism, of a cylindrical exterior casing, and a recessed inner casing, said casings combining to inclose the operating mechanism, and to form a fulcrum and guide therefor, substantially as set forth.

*turn in the case, as shown in Fig.* 1.

CLAIMS.

Having described *my improved bolt and its mode of operation*, what I claim as new, and desire to secure by Letters Patent, is—

1. The combination, with a door-bolt and operating mechanism, of a cylindrical exterior case and a recessed inner case, said cases combining to inclose the operating mechanism and to form a fulcrum and guide therefor, substantially as set forth.

2. The combination of casing A, having opposite holes *a a*, with inner casing B, having transverse groove $b^6$ and slot $b^7$, flat hub D, having crank-arm D′, and the bolt and pitman, substantially as set forth.

[3. The combination of cylindrical outer casing A with inner casing B, having annular front flange $b^1$, side walls $b^4$ $b^4$ transverse partitions $b^5$ and $b^8$, transverse groove $b^6$, and slot $b^7$, said casings being securely fastened together and adapted to receive the bolt and working mechanism, substantially as set forth.

In testimony that I claim the foregoing as my own I affix my signature in presence of two witnesses.]

FRANK DAVIS.

Witnesses:

GEORGE TERRY,
ROGER M. SHERMAN.

2. The combination of case A, having opposite holes, *a a*, with inner case, B, having transverse groove $b^6$ and slot $b^7$, crank D, and the bolt and pitman, substantially as set forth.

3. *The combination of the bolt C, provided with the lug* c, *pitman E, operating as a pitman and spring, and crank D to hold the bolt, substantially as set forth.*

4. *In a cylindrical door-bolt, the pitman E, arranged and adapted to operate as a pitman and spring, substantially as set forth.*

FRANK DAVIS.

Witnesses:

MARTIN MCCORMICK,
CHAS. I. PARKHURST.

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# APPELLEE'S POINTS.

## FIRST POINT.

The reissued patent has four claims. The 1st and 2d of these claims are substantially the same as those of the original patent.

There is no suggestion or pretence that the appellee has infringed upon the exclusive rights of the appellant under either of these two claims.

## SECOND POINT.

No exclusive rights are vested in the appellant under the 3d and 4th claims of the reissued patent.

FIRST. So far as the specification of the reissue describes the mechanism which is the subject of its 3d and 4th claims, it describes an invention different from that set forth in the original patent.

It would not be useful to discuss this point, as it is demonstrated by an inspection and comparison of the two patents.

The specification of the reissue dwells upon a pitman spring as the main feature of the invention, points out its construction and mode of operation, while the specification of the original patent wholly ignores any pitman spring, and gives no hint or suggestion either as to its construction or operation.

It is claimed by the appellant that the drawings of the original patent disclose that the pitman rod was intended to operate as a spring as well as a pitman.

But there is nothing in those drawings to indicate that that the pitman has any function as a spring. They show an inner and outer casing for the bolt; but it will be noted that in figures 4 and 5, which illustrate these casings, there is no stud or projection interposed in the field of movement of the pitman to form a fulcrum whereby the pitman may be bent so as to exert a spring pressure on the bolt. It is plain that unless such bending takes place the action of the pitman is simply comparable to the crank-shaft of an engine, and its office can only be the ordinary office of a crank-shaft—that is, the conversion of rotary motion into a reciprocating motion,—or vice versa.

As to the pitman itself, there is no indication either in the drawings or specification as to the material of which it is made. It might—for anything in the patent to the contrary—be made of iron wire; in which case it could have no spring by any chance.

Figure 3 shows the pitman and connections with the crank arm and bolt.

The connection with the crank arm is, of course, a pivotal connection—that is, the end of the wire is inserted into a hole in the crank, and as the crank arm is turned, the wire revolves in the hole. Now if the connection of the other end of the wire with the bolt be of the same loose character, it is evident that, (in the absence of any fulcrum between the two ends of the wire), it would not be possible to bend or spring the wire by turning the crank.

In the drawing, the connection with the bolt is shown the same as the connection with the crank, and as this latter is *known* to be a loose connection, the information afforded by the drawings suggests only the ordinary crank shaft action of the pitman.

We submit, therefore, that there is nothing in the drawings of the original patent which shows that any spring action of the pitman was contemplated, and no mechanic would suppose that the pitman shown in figure 3 had any other than the ordinary function of a pitman.

But as is said by the Circuit Court in its opinion (page 23, fol. 47.)

> "It seems to me that it is useless to discuss this question, because, if the alleged mistake could have been safely and permanently corrected by seasonable application to the Patent Office, the patentee and assignee had at the time of the application for a reissue, lost their rights by their own laches.

## THIRD POINT.

All the elements, either of which, has so often been recognized by this court as fatal to the validity of a reissue, are combined in this reissue.

I. The reissue was not applied for until more than two years and a-half after the original patent was granted.

II. Its claims were expanded to include an invention not hinted at, in either of the claims of the original patent.

III. For months before the reissue was applied for, the appellee had lawfully manufactured, and the public had rightfully dealt in, the thing which is now presented to this court by the appellant as an infringement of his exclusive rights under the expanded claims of his reissue.

FIRST. From these conceded premises, the conclusion that this reissue is void as to these expanded claims, has been so often and so recently announced by this court, that it cannot be useful here to cite the numerous cases containing such announcement.

SECOND. The appellant conceding that the maxim "*stare decisis*" would compel an affirmation of the decree of the Circuit Court, seeks to extricate this reissue from those decisions by attempting to prove certain irrelevant facts by incompetent testimony.

I. By a claimed conversation between the patentee and a solicitor whom he sought to employ to obtain his original patent.

> "Int. 8. To whom did you go to make your application for a patent?
>
> Ans. George Terry, patent solicitor, New Haven.
>
> Int. 12. State what conversation you had with Mr.

Terry, and what directions you gave Mr. Terry on applying for a patent on your invention?

Ans. I explained to Mr. Terry that I had got the spring, answering for a spring, and also for turning the bolt, a pitman-spring. I didn't know the term at that time.

Int. 13. What did you describe to him as the invention which you wished to have patented?

Ans. This pitman-spring, and this guard, lever, and purchase that it had in holding the bolt out or back; also, in moving the bolt out and back.

Int. 14. State whether Mr. Terry took out your patent or not?

Ans. It was not his hand writing. I should judge not."

Record, p. 11, fol. 24.

(See also to the same effect testimony of Mr. Terry, p. 17, fol. 34.)

But clearly a patentee cannot, as against the public, enlarge his rights by attempting to recall, after intervening years, a casual conversation with a solicitor who then declined to act for him, but whose memory, it seems, is now at his service.

II. Another extricating fact relied upon by the appellant, is that, although the patentee received the patent by mail in April, 1878, it does not appear that he ever read it between that time and its sale to the appellant in May, 1879

"Int. 17. When did you receive the patent after its

issue by the office, and where were you and how did it come?

Ans. It was in April; I was in North Adams; it came by mail.

Int. 18. In what kind of an enclosure was it?

Ans. In a square pasteboard envelope.

(Witness is shown exhibit copy of the "Assignment" which has been put in evidence.)

Int. 22. Is that your signature?

Ans. Yes, sir.

Int. 23. Up to the date of that assignment, who had possession of the patent papers?

Ans. I did.

Int. 24. Were they then delivered to Mr. Ives with the assignment?

Ans. They were.

Int. 25. When did you first hear that there was any trouble about the claims in that patent? State circumstances?

Ans. The winter of 1880, I am sure; Mr. Ives called my attention to it, brought a piece of a bolt with this spring attached to it, saying that there were parties infringing on him, but at that time didn't tell me what part. A month or two later I saw him again, and he told me that they were using that spring. I told him that no one had any right to use that spring because it was the main thing in my last patent."

Folios 24 and 25.

III. And it also gravely urged in behalf of the appellant, that *he* has no positive recollection that he ever read

the patent at the time of its purchase by him in May, 1879, or that he had ever read or heard it read prior to that time.

> "Int. 18. Had you seen his patent at that time?
>
> Ans. I don't think I had.
>
> Int. 19. When was the first time that you remember to have seen it?
>
> Ans. About a year afterwards I bought the entire patent, and then, I think, I read the patent over, but couldn't say positively that I did then."

IV. These claimed facts, even if they could be proved by competent evidence, do not extricate this reissue from the now well settled rule that the laches of the patentee will defeat his right to correct by a reissue even an admitted mistake by which the invention is restricted within too narrow limits.

> "No one should be relieved who has slept upon his rights and has thus led the public to rely on the implied disclaimer involved in the terms of the original patent."
>
> Miller *vs.* Brass Co., 104 U. S., 350.

V. The fallacy of the appellant's argument on this question of laches, seems to reside in his ignoring that this issue is one between himself and the public, and not, as he assumes, between himself and the appellee.

As between individual contestants, it may so be that circumstances and surroundings may, in certain cases, excuse apparent laches, but as between the patentee and the public, laches disclosed by the records of the Patent Office admit of no excuses.

The same fatality to the patentee results whether the laches are due to his fault in not taking prompt action to protect his known rights, or to his negligence in not using the means and opportunities to inform himself as to what his rights are.

> "It is not merely a question as to what information respecting their rights parties do actually obtain, but as to what information they might have obtained had they used the means and opportunities directly at their command."
>
> Hoyt *vs.* Sprague, 103 U. S., 613.

> "But it is urged that the inventor did not acquiesce. He knew nothing of the rejection, for the reason that he never examined the letters patent from the time he received them until the spring of 1877. This will not do. The law will not permit a party to relieve himself from the charge of negligence by asserting that he closed his eyes and ears at the time when he was required to keep his faculties awake. The enquiry is, not what the inventor knew, but he ought to have known,—what he could have ascertained by the exercise of ordinary care and diligence. To hold otherwise would be to place a premium upon carelessness, stupidity and fraud."
>
> Arnheim *vs.* Finster and others, 26 Fed., Rep. 280.

VI. Even in exceptional cases, where there has been no actual fault or positive negligence, laches —if that term can properly apply to such a case—will defeat the effort of a patentee to expand the claim of his original patent, to the prejudice of the public, when its rights have been intervened between the date of the patent and the application for a reissue.

> "Great stress is laid upon the fact that the complainant is a Frenchman, and unfamiliar with the English language. He was, it is said, ignorant that the claim in dispute had been finally omitted until a fortnight before the application for the reissue. Should such excuses be accepted by the courts? These questions must be determined upon broad and general principles. The march of the law cannot be arrested or diverted from the broad and traveled highway, to deal specially with each isolated and peculiar transaction. No two cases are precisely similar, and the rule should not be changed because of slight variations upon the facts. Ignorance of domestic law is never an excuse, nor is ignorance of a fact, when it is traceable to culpable negligence of the party who seeks relief. Were it otherwise, inadvertence and mistake would be synonymous with willful and intentional neglect. To hold that the complainant's failure to understand our language exonerates him, would lead logically to the conclusion that a patent might legally be reissued to a foreigner what would be held invalid, if reissued in like circumstances to an American. * * To every patent the public is an indirect party. It is for the advantage of the whole people that all meritorious inventions shall be protected, but it is clearly the duty of the courts to see to it that the public is not required to pay tribute for that which may be fairly considered as abandoned by the inventor."

Boland *vs.* Thompson, 26 Fed. Rep., 634.

## FOURTH POINT.

Upon principle and upon authority the decree of the Circuit Court dismissing this bill should be affirmed.

JOHN S. BEACH,

*Counsel for Appellee.*